IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
ON APPEAL FROM THE EXAMINER TO THE BOARD
OF PATENT APPEALS AND INTERFERENCES

In re Application of:	Philip S. Siegel
U.S. Patent Serial No.:	10/750,935
Filing Date:	January 2, 2004
Group No.:	3627
Examiner:	Mussa A. Shaawat
Confirmation No.:	1902
Title:	ON-LINE RULES-BASED RETURN PROCESSING

MAIL STOP APPEAL BRIEF - PATENTS
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Dear Sir:

APPEAL BRIEF

Appellant has appealed to the Board of Patent Appeals and Interferences ("Board") from the Final Office Action dated November 20, 2008. Appellant filed a Notice of Appeal and Pre-Appeal Brief on January 20, 2009 with the statutory fee of $270.00. This Appeal Brief is filed in response to Notice of Panel Decision from Pre-Appeal Brief Review dated February 10, 2009, finally rejecting Claims 1, 2, 4-7, 9, 11-15, 17, and 19-27.

Real Party In Interest

This Application is currently owned by Newgistics, Inc. as indicated by:

an assignment recorded on 09/24/2004 from inventor Philip S. Siegel to Ireturnit, Inc., in the Assignment Records of the PTO at Reel 015172, Frame 0526 (3 pages); and

an assignment recorded on 9/24/2004 from Ireturnit, Inc. to Newgistics, Inc., in the Assignment Records of the PTO at Reel 015172, Frame 0543 (2 pages).

Related Appeals and Interferences

Appellant directs the Board's attention to following pending Applications that are under appeal and may be related to or affect the bearing on the Board's decision in this Appeal:

1. United States Patent Application Serial No. 09/817,353, entitled "System And Method For Single-Action Returns of Remotely Purchased Merchandise" filed on March 26, 2001, which claims the benefit of U.S. Provisional Application No. 60/191,811, filed March 24, 2000.

    The current Application at issue is a Continuation of United States Patent Application Serial No. 09/817,353.

    A copy of the Appeal Brief filed on April 15, 2009, as relating United States Patent Application Serial No. 09/817,353, is included in Appendix C, attached hereto.

2. United States Patent Application Serial No. 10/751,216, entitled "On-line Merchandise Return Labels" filed on January 2, 2004, which is also a Continuation of United States Patent Application Serial No. 09/817,353, entitled "System And Method For Single-Action Returns of Remotely Purchased Merchandise" filed on March 26, 2001, which claims the benefit of U.S. Provisional Application No. 60/191,811, filed March 24, 2000.

    A copy of the Appeal Brief filed on April 15, 2009, as relating United States Patent Application Serial No. 10/751,216, is included in Appendix C, attached hereto.

To the knowledge of Appellant's counsel, there are no other known appeals, interferences, or judicial proceedings that will directly affect or be directly affected by or have a bearing on the Board's decision regarding this Appeal.

Status of Claims

Claims 1, 2, 4-7, 9, 11-15, 17, and 19-27 are pending and stand rejected pursuant to the Final Office Action dated November 20, 2008 (*"Final Office Action"*). Specifically, Claims 1-2, 4-7, 9, 11-15, 17, and 19-27 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,980,962 issued to Arganbright et al. (*"Arganbright"*) in view U.S. Patent Application Publication No. 2002/0010634 issued to Roman et al. (*"Roman"*) and further in view of U.S. Patent No. 6,246,997 issued to Cybul et al. (*"Cybul"*). A Notice of Panel Decision from Pre-Appeal Brief Review dated February 10, 2009 (*"Panel Decision"*) maintains these rejections. Claims 3, 8, 10, 16, and 18 have been cancelled without prejudice or disclaimer.

For the reasons discussed below, Appellant respectfully submits that the rejection of Claims 1-2, 4-7, 9, 11-15, 17, and 19-27 are improper and should be reversed by the Board. Accordingly, Appellant presents Claims 1-2, 4-7, 9, 11-15, 17, and 19-27 for Appeal. All pending claims are shown in Appendix A, attached hereto.

Status of Amendments

All amendments submitted by Appellant have been entered by the Examiner.

Summary of Claimed Subject Matter

FIGURES 1A-1B illustrate web pages incorporating teachings of the present invention. Specifically, FIGURE 1A illustrates a web access tool displaying a web page containing transaction history 101 which includes individual transactions indicative of merchandise purchased by a user logged on to a client system. This example web page was preferably sent from a server system to the client system when the user logged on to the client system and requested to process a merchandise return. This example web page contains transaction listing 101, returns summary section 102, single-action returns section 103, detailed item description section 104, user identification section 107, and returns information section 108. One skilled in the art can appreciate that these various sections may be omitted, rearranged or adapted in various ways without departing from the spirit and scope of the present invention. In general, the user is preferably made aware of the item or items to be returned by the single action and of the single action needed to begin the returns process. (Page 10, lines 7-26.)

Transaction listing 101 and detailed item description section 104 preferably provide information that identifies and describes the item(s) selected by the user and which may be returned. The server system adds transaction listing 101 and detailed item description 104 to each web page for the item(s) the user has purchased from various retailers. The server system, however, preferably adds single-action returns section 103 when single-action ordering is enabled for the user logged onto the client system. One skilled in the art would appreciate that a single web page on the server system may contain all these sections but single-action returns section 103 may be selectively included or excluded before sending the web page to the client system. (Page 10, line 27 - page 11, line 9.)

Single-action returns section 103 allows the user to specify, with a single action such as a single click of a mouse button, to return items of merchandise selected from individual transactions contained in transactions listing 101. Once the user has performed the preferred single action, the returns process for the selected item(s) is initiated. Single-action returns section 103 preferably contains single-action return button 103a, user identification subsection 103b, and single-action return information subsections 103c and 103d. (Page 11, lines 10-19.)

When the user selects single-action returns button 103a, the client system sends a return request to the server system indicating the user's desire that the merchandise items associated with transactions selected in transaction listing 101 be returned. After the server system

receives the return request, the server system provides the client system with a new web page confirming the receipt of the return request. The processing of the client system and the server system will be discussed in greater detail below. (Page 12, lines 17-26.)

FIGURE 2 is a block diagram illustrating a system incorporating teachings of the present invention. System 200 preferably supports single-action returns over the Internet using the World Wide Web. Server system 210 includes server engine 211, client identifier/customer table 212, various web page templates 213, customer database 214, transaction database 215, and retailer database 216. Server engine 211 preferably receives HTTP (Hypertext Transfer Protocol) requests to access web pages identified by URLs (Universal Resource Locator) and provides the web pages to the various client systems 220. Such an HTTP request may indicate that the user has performed the single action necessary to effect single-action returns. (Page 14, lines 6-19.)

Customer database 214 preferably contains customer information for various users or potential users. Customer information may include user-specific return information such as the name of the customer, credit information, and shipping information in a user preference profile. Transaction database 215 preferably contains entries indicative of transactions associated with registered users, preferably transactions which were performed at single-action returns participating retailers. Retailer database 216 contains a listing of the various retailers that participate in a local returns of remotely purchased merchandise program. Client identifier/customer table 212 contains a mapping from each client identifier, which is a globally unique identifier that uniquely identifies a client system, to the customer last associated with that client system. (Page 14, line 20 - page 15, line 4.)

FIGURE 5 is a flow diagram of a routine capable of processing single-action returns according to one embodiment of the present invention . . . Method 500 of FIGURE 5 begins at step 505. Once initialized, method 500 proceeds to step 510. At step 510, the user of client system 220 is identified. One method of identifying the user of client system 220 is the method of FIGURE 3. An alternative method of identifying the user of client system 220 is to obtain and review client identifier 222, if one is present, on client system 220. If the user of the client system is a new user, i.e., not yet registered or no client identifier 222 is provided, method 500 proceeds to step 515. (Page 18, lines 5-20.)

At step 515, it is determined whether or not the user is to be registered. This determination can be made by prompting the user, or by other means. If the new user does not

wish to be registered for single-action returns services or it is determined that the user is not to be registered, method 500 proceeds to step 520 where method 500 is ended. If the new user wishes to enable single-action returns, method 500 proceeds to step 525. (Page 18, lines 21-28.)

At step 525, a user preference profile for the new user is created and stored preferably on server system 210. Once the new user is registered and the user preference profile stored, a client identifier 222 is deposited on client system 220 and method 500 proceeds to step 535. (Page 18, line 29 - page 19, line 3.)

If at step 510, the user on client system 220 is identified as a registered user, i.e., a client identifier 222 exists on client system 220, method 500 proceeds to step 530. At step 530, the user preference profile of the registered user is retrieved and mapped using customer database 214 and client ID/customer table 212. Once the user preference profile has been retrieved, such as at step 530, or created, such as at step 525, method 500 proceeds to step 535. (Page 19, lines 4-12.)

At step 535, a transaction history for the user is preferably retrieved from transactions database 215. Transactions database 215 is preferably maintained by server system 210. However, transactions database 215 can be maintained at another location as well as created real-time from a collection of databases located at member retail sites, credit card sites or other data bases. Once an appropriate transaction history for the registered user has been retrieved at step 535, method 500 proceeds to step 540. (Page 19, lines 13-22.)

At step 540, the transaction history retrieved at step 535 is preferably displayed to the user for their perusal and subsequent selection of items of merchandise to be returned. The transaction history is preferably displayed in a manner similar to that illustrated in FIGURE 1A. In addition to the transaction history, single-action returns section 103 of the present invention is also preferably included on the displayed web page. Once transaction history 101 and other desired components of a single-action returns web page are displayed, method 500 proceeds to step 545. (Page 19, line 23 - page 20, line 2.)

At step 545, method 500 waits or loops until the user selects a transaction or item to be processed for returns. If a transaction or item is not selected within a predetermined amount of time, method 500 proceeds to step 550 where method 500 ends. Method 500 is designed to end after a predetermined amount of time for security reasons which can arise from client system 220 being left unattended or for other computer security threats. In response to the selection of

an item to be returned and the subsequent selection of single-action returns button 103a at step 545, method 500 proceeds to step 555. At step 555, the processing necessary for the return of the selected item or items of merchandise is initiated. (Page 20, lines 3-15.)

Referring now to FIGURE 6A, one embodiment of a flow diagram capable of completing the processing of a return request incorporating teachings of the present invention is shown. As illustrated in the embodiment of FIGURE 6A, in response to the initiation of returns processing at step 555, method 500a proceeds to step 558. (Page 20, lines 16-21.)

At step 558, the selected item or transaction is evaluated to determine whether or not the return is a valid return. One method of validating a return might involve comparing the item to be returned against a returns rule set for the retailer from which the item was purchased. Alternatively, if the transaction represented the purchase of a perishable item, a return might be determined to not be valid. If it is determined that the selected transaction or item is not a valid return, method 500a proceeds to step 561. (Page 20, lines 22-31.)

At step 561, the user is notified of the invalid return such as by a web page, email, or other capable means. Once the user has been notified that the return is invalid at step 561, method 500a ends at step 564. As an alternative to ending at any end step of methods 500, 500a or 500b, methods 500, 500a or 500b can return to a previous step, such as step 540 where the transaction listing is displayed to the user, or perform other actions within the spirit and scope of the present invention. (Page 21, lines 1-10.)

If at step 558, it is determined that the selected item or transaction for return is valid, method 500a proceeds to step 567. At step 567, the retailer from which the item was purchased is notified of the pending merchandise return. After the appropriate retailer is notified at step 567, the transaction information and the necessary user specific information such as that contained in the user preference profile, is provided to the retailer at step 570. (Page 21, lines 11-19.)

In addition to providing the retailer the necessary transaction information and the necessary user specific information at step 570, a shipping agent is notified of the need for a package pick up such that the item selected by the user may be returned at Step 573. To further simplify processing for both the shipping agent and the user, a return shipping label is preferably produced for the user to place on the package in which the merchandise for return will be shipped back to the retailer at step 576. It is also possible to have shipping paperwork generated and printed out at the facility of the shipping agent. At step 579, the package, once

picked up by the shipping agent, is forwarded to the appropriate destination, such as a retailer depot, auction site, etc. Method 500a completes returns processing at step 582. (Page 21, line 20 - page 22, line 4.)

Referring now to FIGURE 6B, an alternate embodiment of a flow diagram capable of completing the processing of a single-action return request incorporating teachings of the present invention is shown. Similar to FIGURE 6A, in response to the initiation of returns processing at step 555, method 500b proceeds to step 558. (Page 22, lines 5-10.)

At step 558, the selected item or transaction is evaluated to determine whether or not the return is a valid return. One method of validating a return might be to compare the item to be returned against a returns rule set for the retailer from which the item was purchased. Alternatively, if the transaction represented the purchase of a perishable item, a return might be determined to not be valid. If it is determined that the selected transaction or item is not a valid return, method 500b proceeds to step 561. (Page 22, lines 11-20.)

At step 561, the user is notified of the invalid return. Once the user has been notified that the return is invalid at step 561, method 500b ends at step 564. (Page 22, lines 21-23.)

If at step 558, it is determined that the selected item or transaction for return is valid, method 500b proceeds to step 573. At step 573, a shipping agent is notified of a package pick up for the return of the item selected by the user. To further simplify processing for both the shipping agent and the user, a return shipping label is preferably produced for the user to place on the package in which the return will be shipped at step 576. At step 579, the package, once picked up by the shipping agent, is forwarded to its appropriate destination. (Page 22, line 24 - page 23, line 2.)

Once the merchandise to be returned has been received at its destination or while the merchandise is in transit, the merchandise is disposed of at step 585. The present invention envisions a variety of different methods by which the returned merchandise may be disposed of. For example, the merchandise may be auctioned on an auctioning web-site, a live auction may be employed to dispose of the returned merchandise, or as illustrated in FIGURE 6A, the merchandise may be returned to the retailer from which it was purchased. (Page 23, lines 3-12.)

Once the merchandise has been disposed of at step 585, the proceeds of the disposal are credited to the user based upon settings available in the user preference profile at step 588. This method of disposal allows an auctioning agent to obtain the best price for the returned

merchandise and to collect a commission for their role in the disposition of the merchandise should they desire. For products which get returned to the retailer from which they were purchased, the user may be able to obtain a full refund for the unwanted merchandise from the retailer. Other methods of merchandise disposal are considered within the spirit and scope of the present invention. Once the user has been appropriately credited, method 500b completes at step 591. (Page 23, lines 13-26.)

To help minimize shipping costs and user confusion, the server system may combine various single-action returns into a multiple-item return. For example, if a user wishes to return more than one item to any given retailer or central depot, those returns may be cost effectively combined into a single return for shipping. As such, the server system preferably combines the single-action returns when their destination addresses are the same. (Page 23, line 27 - page 24, line 4.)

Although the present invention has been described in detail, it should be understood that various changes, substitutions and alterations can be made thereto without departing from the spirit and scope of the invention. (Page 26, lines 25-28.)

With regard to the independent claims currently under Appeal, Appellant provides the following concise explanation of the subject matter recited in the claim elements. For brevity, Appellant does not necessarily identify every portion of the Specification and drawings relevant to the recited claim elements. Additionally, this explanation should not be used to limit Appellant's claims but is intended to assist the Board in considering the Appeal of this Application.

For example, independent Claim 1 recites the following:

> A method of using a computer system for on-line processing of merchandise returns for a plurality of merchants (e.g., Figures 5 and 6A-6B, reference numerals 500-588; Page 18, line 5 through Page 24, line 4), comprising the steps of:
> storing a set of return rules in a database for each of the plurality of merchants (e.g., Figure 5, reference numeral 558; Page 20, lines 22-31);
> receiving, via the Internet, a return request representing a request by a customer to initiate a return of at least one item of merchandise (e.g., Figure 1, reference numerals 101-110; Page 10, lines 7-16; Figure 5, reference numeral 510; Page 18, lines 10-20);
> in response to receiving the return request from the customer, gathering transaction history data associated with the customer from a computerized database (e.g., Figure 5, reference numeral 535; Page 19, lines 13-22);

displaying the transaction history to the customer for selection of a particular item of merchandise within a listing of merchandise included in the transaction history (e.g., Figure 5, reference numeral 540; Page 19, line 23 through page 20, line 2);

receiving, from a customer, an electronic selection by a click on the particular item of merchandise in the displayed listing of merchandise, the electronic selection identifying the particular item of merchandise for returns processing (e.g., Figure 5, reference numeral 545; Page 20, lines 3-15);

in response to receiving the click on the particular item of merchandise in the listing of merchandise, using the set of return rules associated with the identified merchant and the transaction information to validate the return (e.g., Figure 5, reference numeral 558; Page 20, lines 10-31);

upon validating the return, electronically delivering data about the customer to the merchant associated with the return (e.g., Figure 5, reference numeral 567; Page 21, lines 11-19);

processing the return in accordance with the set of return rules associated with the merchant (e.g., Figures 6A-6B, reference numerals 558-588; Page 20, line 16 through Page 23, line 26).

Dependent Claim 6 incorporates the steps of Claim 1 and further recites the following:

wherein the processing step is performed by determining disposition of the item (e.g., Figures 6A-6B, reference numerals 585; Page 23, line 3-12).

Dependent Claim 9 incorporates the steps of Claim 1 and further recites the following:

wherein the processing step is performed by crediting an account of the customer (e.g., Figures 6A-6B, reference numerals 588; Page 23, line 13-16).

Dependent Claim 14 incorporates the steps of Claim 1 and further recites the following:

notifying a shipping agent of the return (e.g., Figures 6A-6B, reference numeral 573; Page 21, lines 20-24; Page 22, lines 26-28).

As another example, independent Claim 15 recites the following:

An on-line merchandise return system for processing merchandise returns for a plurality of merchants (e.g., Figures 1A-1B, reference numerals 100- 108; Page 10, line 7 through Page 14, line 5; Figure 2, reference numerals 200-230; Page

14, line 6 through Page 16, line 4), comprising a computer system (e.g., Figure 2, reference numeral 211; Page 14, lines 9-19) programmed to:

store a set of return rules in a database for each of the plurality of merchants (e.g., Figure 2, reference numerals 214-216; Page 14, lines 20-31);

receive a return request, via the Internet, representing a request by a customer to initiate a return at least one item of merchandise (e.g., Figure 1, reference numerals 101-110; Page 10, lines 7-16; Figure 5, reference numeral 510; Page 18, lines 10-20);

in response to receiving the return request from the customer, gather transaction history data associated with the customer from a computerized database (e.g., Figure 1, reference numeral 101; Page 10, line 26 through Page 11, line 9; Figure 5, reference numeral 535; Page 19, lines 13-22);

display the transaction history to the customer for selection of a particular item of merchandise within a listing of merchandise included in the transaction history (e.g., Figure 1, reference numeral 101; Page 10, line 26 through Page 11, line 9; Figure 5, reference numeral 540; Page 19, line 23 through page 20, line 2);

receive, from a customer, an electronic selection by a click on the particular item of merchandise in the displayed listing of merchandise, the electronic selection identifying the particular item of merchandise for returns processing (e.g., Figure 1, reference numeral 103; Page 11, lines 10-19; Figure 5, reference numeral 545; Page 20, lines 3-15);

in response to receiving the click on the particular item of merchandise in the listing of merchandise, use the set of return rules associated with the identified merchant and the transaction information to validate the return (e.g., Figure 5, reference numeral 558; Page 20, lines 10-31);

upon validating the return, electronically deliver data about the customer to the merchant associated with the return (e.g., Figure 5, reference numeral 567; Page 21, lines 11-19); and

process the return in accordance with the set of return rules associated with the merchant (e.g., Figures 6A-6B, reference numerals 558-588; Page 20, line 16 through Page 23, line 26).

As another example, independent Claim 17 recites the following:

Software for facilitating online merchandise return services (e.g., Figures 1A-1B, reference numerals 100- 108; Page 10, line 7 through Page 14, line 5; Figure 2, reference numerals 200-230; Page 14, line 6 through Page 16, line 4), the software embodied in a computer-readable medium and when executed operable to:

store a set of return rules in a database for each of the plurality of merchants (e.g., Figure 5, reference numeral 558; Page 20, lines 22-31);

receive, via the Internet, a return request representing a request by a customer to initiate a return of at least one item of merchandise (e.g., Figure 1, reference numerals 101-110; Page 10, lines 7-16; Figure 5, reference numeral 510; Page 18, lines 10-20);

in response to receiving the return request from the customer, gather transaction history data associated with the customer from a computerized database (e.g., Figure 5, reference numeral 535; Page 19, lines 13-22);

display the transaction history to the customer for selection of a particular item of merchandise within a listing of merchandise included in the transaction history (e.g., Figure 5, reference numeral 540; Page 19, line 23 through page 20, line 2);

receive, from a customer, an electronic selection by a click on the particular item of merchandise in the displayed listing of merchandise, the electronic selection identifying the particular item of merchandise for returns processing (e.g., Figure 1, reference numerals 101-110; Page 10, lines 7-16; Figure 5, reference numeral 510; Page 18, lines 10-20);

in response to receiving the click on the particular item of merchandise in the listing of merchandise, use the set of return rules associated with the identified merchant and the transaction information to validate the return (e.g., Figure 5, reference numeral 558; Page 20, lines 10-31);

upon validating the return, electronically deliver data about the customer to the merchant associated with the return (e.g., Figure 5, reference numeral 567; Page 21, lines 11-19); and

process the return in accordance with the set of return rules associated with the merchant (e.g., Figures 6A-6B, reference numerals 558-588; Page 20, line 16 through Page 23, line 26).

As another example, independent Claim 19 recites the following:

A method of using a computer for online merchandise returns (e.g., Figure 2, reference numerals 200-230; Page 14, line 6 through Page 16, line 4), comprising the steps of:

receiving, from each of a plurality of merchants, a set of return rules representing merchandise return policies of each merchant (e.g., Figure 2, reference numerals 214-216; Page 14, lines 20-31; Figure 5, reference numeral 558; Page 20, lines 22-31);

storing the return rules in a database (e.g., Figure 2, reference numerals 214-216; Page 14, lines 20-31);

receiving, via the Internet, a return request representing a request by a customer to initiate a return of at least one item of merchandise (e.g., Figure 1, reference numerals 101-110; Page 10, lines 7-16; Figure 5, reference numeral 510; Page 18, lines 10-20);

in response to receiving the return request from the customer, gathering transaction history data associated with the customer from a computerized database (e.g., Figure 5, reference numeral 535; Page 19, lines 13-22);

displaying the transaction history to the customer for selection of a particular item of merchandise within a listing of merchandise included in the transaction history (e.g., Figure 5, reference numeral 540; Page 19, line 23 through page 20, line 2);

receiving, from a customer, an electronic selection by a click on the particular item of merchandise in the displayed listing of merchandise, the electronic selection identifying the particular item of merchandise for returns

processing (e.g., Figure 1, reference numerals 101-110; Page 10, lines 7-16; Figure 5, reference numeral 510; Page 18, lines 10-20);

in response to receiving the click on the particular item of merchandise in the listing of merchandise, using the set of return rules associated with the identified merchant to validate the return (e.g., Figure 5, reference numeral 558; Page 20, lines 10-31);

upon validating the return, processing the return in accordance with the set of return rules associated with the merchant (e.g., Figures 6A-6B, reference numerals 558-588; Page 20, line 16 through Page 23, line 26).

As another example, independent Claim 20 recites the following:

An on-line merchandise return system for processing merchandise returns for a plurality of merchants (e.g., Figures 1A-1B, reference numerals 100- 108; Page 10, line 7 through Page 14, line 5; Figure 2, reference numerals 200-230; Page 14, line 6 through Page 16, line 4), comprising a computer system (e.g., Figure 2, reference numeral 211; Page 14, lines 9-19) programmed to:

receive, from each of a plurality of merchants, a set of return rules representing merchandise return policies of each merchant (e.g., Figure 2, reference numerals 214-216; Page 14, lines 20-31; Figure 5, reference numeral 558; Page 20, lines 22-31);

store the return rules in a database (e.g., Figure 2, reference numerals 214-216; Page 14, lines 20-31);

receive, via the Internet, a return request representing a request by a customer to initiate a return of at least one item of merchandise (e.g., Figure 1, reference numerals 101-110; Page 10, lines 7-16; Figure 5, reference numeral 510; Page 18, lines 10-20);

in response to receiving the return request from the customer, gather transaction history data associated with the customer from a computerized database (e.g., Figure 5, reference numeral 535; Page 19, lines 13-22);

display the transaction history to the customer for selection of a particular item of merchandise within a listing of merchandise included in the transaction history (e.g., Figure 5, reference numeral 540; Page 19, line 23 through page 20, line 2);

receive, from a customer, an electronic selection by a click on the particular item of merchandise in the displayed listing of merchandise, the electronic selection identifying the particular item of merchandise for returns processing (e.g., Figure 1, reference numerals 101-110; Page 10, lines 7-16; Figure 5, reference numeral 510; Page 18, lines 10-20);

in response to receiving the click on the particular item of merchandise in the listing of merchandise, use the set of return rules associated with the identified merchant to validate the return (e.g., Figure 5, reference numeral 558; Page 20, lines 10-31);

upon validating the return, process the return in accordance with the set of return rules associated with the merchant (e.g., Figures 6A-6B, reference numerals 558-588; Page 20, line 16 through Page 23, line 26).

As another example, independent Claim 21 recites the following:

Software for facilitating online merchandise return services for a plurality of merchants (e.g., Figures 1A-1B, reference numerals 100- 108; Page 10, line 7 through Page 14, line 5; Figure 2, reference numerals 200-230; Page 14, line 6 through Page 16, line 4), the software embodied in a computer-readable medium and when executed operable to:

receive, from each of a plurality of merchants, a set of return rules representing merchandise return policies of each merchant (e.g., Figure 2, reference numerals 214-216; Page 14, lines 20-31; Figure 5, reference numeral 558; Page 20, lines 22-31);

store the return rules in a database (e.g., Figure 2, reference numerals 214-216; Page 14, lines 20-31);

receive, via the Internet, a return request representing a request by a customer to initiate a return of at least one item of merchandise (e.g., Figure 1, reference numerals 101-110; Page 10, lines 7-16; Figure 5, reference numeral 510; Page 18, lines 10-20);

in response to receiving the return request from the customer, gather transaction history data associated with the customer from a computerized database (e.g., Figure 5, reference numeral 535; Page 19, lines 13-22);

display the transaction history to the customer for selection of a particular item of merchandise within a listing of merchandise included in the transaction history (e.g., Figure 5, reference numeral 540; Page 19, line 23 through page 20, line 2);

receive, from a customer, an electronic selection by a click on the particular item of merchandise in the displayed listing of merchandise, the electronic selection identifying the particular item of merchandise for returns processing (e.g., Figure 1, reference numerals 101-110; Page 10, lines 7-16; Figure 5, reference numeral 510; Page 18, lines 10-20);

in response to receiving the click on the particular item of merchandise in the listing of merchandise, use the set of return rules associated with the identified merchant to validate the return (e.g., Figure 5, reference numeral 558; Page 20, lines 10-31);

upon validating the return, process the return in accordance with the set of return rules associated with the merchant (e.g., Figures 6A-6B, reference numerals 558-588; Page 20, line 16 through Page 23, line 26).

As another example, independent Claim 22 recites the following:

A method of using a computer system for on-line processing of merchandise returns (e.g., Figure 2, reference numerals 200-230; Page 14, line 6 through Page 16, line 4), comprising the steps of:

in a first transaction associated with an online purchase of at least one item of merchandise, obtaining customer-specific return information from a customer associated with the at least one item of merchandise (e.g., Figure 2, reference

numeral 214; Page 14, lines 20-25; Figure 3, reference numeral 214; Page 16, lines 5-20);

transmitting a client identifier to a client system associated with the customer (e.g., Figure 2, reference numerals 212, Page 14, line 31 through Page 15, line 21; Figure 5, reference numeral 510; Page 18, lines 11-20);

in a second transaction, receiving, via the Internet, a return request representing a request by the customer to initiate a return of at least one item of merchandise, the return request comprising the client identifier that uniquely identifies the client system from which the return request is received (e.g., Figure 1, reference numerals 101-110; Page 10, lines 7-16; Page 15, lines 5-21 Figure 5, reference numeral 510; Page 18, lines 10-20);

using the client identifier to identify the customer-specific return information (e.g., Figure 2, reference numerals 212, Page 14, line 31 through Page 15, line 21; Figure 5, reference numeral 510; Page 18, lines 11-17; Page 19, lines 4-12);

processing the return in accordance with one or more return rules associated with the merchandise (e.g., Figures 6A-6B, reference numerals 558-588; Page 20, line 16 through Page 23, line 26); and

electronically notifying a merchant of the return (e.g., Figure 5, reference numeral 567; Page 21, lines 11-19).

As another example, independent Claim 24 recites the following:

An on-line merchandise return system (e.g., Figures 1A-1B, reference numerals 100- 108; Page 10, line 7 through Page 14, line 5; Figure 2, reference numerals 200-230; Page 14, line 6 through Page 16, line 4), comprising a computer system (e.g., Figure 2, reference numeral 211; Page 14, lines 9-19) programmed to:

in a first transaction associated with an online purchase of at least one item of merchandise, obtain customer-specific return information from a customer associated with the at least one item of merchandise (e.g., Figure 2, reference numeral 214; Page 14, lines 20-25; Figure 3, reference numeral 214; Page 16, lines 5-20);

transmit a client identifier to a client system associated with the customer (e.g., Figure 2, reference numerals 212, Page 14, line 31 through Page 15, line 21; Figure 5, reference numeral 510; Page 18, lines 11-20);

in a second transaction, receive, via the Internet, a return request representing a request by the customer to initiate a return of at least one item of merchandise, the return request comprising the client identifier that uniquely identifies the client system from which the return request is received (e.g., Figure 1, reference numerals 101-110; Page 10, lines 7-16; Page 15, lines 5-21 Figure 5, reference numeral 510; Page 18, lines 10-20);

use the client identifier to identify the customer-specific return information (e.g., Figure 2, reference numerals 212, Page 14, line 31 through Page 15, line 21; Figure 5, reference numeral 510; Page 18, lines 11-17; Page 19, lines 4-12);

process the return in accordance with one or more return rules associated with the merchandise (e.g., Figures 6A-6B, reference numerals 558-588; Page 20, line 16 through Page 23, line 26); and

electronically notify the merchant of the return (e.g., Figure 5, reference numeral 567; Page 21, lines 11-19).

As another example, independent Claim 26 recites the following:

Software for facilitating online merchandise return services (e.g., Figures 1A-1B, reference numerals 100- 108; Page 10, line 7 through Page 14, line 5; Figure 2, reference numerals 200-230; Page 14, line 6 through Page 16, line 4), the software embodied in a computer-readable medium and when executed operable to:

in a first transaction associated with an online purchase of at least one item of merchandise, obtain customer-specific return information from a customer associated with the at least one item of merchandise (e.g., Figure 2, reference numeral 214; Page 14, lines 20-25; Figure 3, reference numeral 214; Page 16, lines 5-20);

transmit a client identifier to a client system associated with the customer (e.g., Figure 2, reference numerals 212, Page 14, line 31 through Page 15, line 21; Figure 5, reference numeral 510; Page 18, lines 11-20);

in a second transaction, receive, via the Internet, a return request representing a request by the customer to initiate a return of at least one item of merchandise, the return request comprising the client identifier that uniquely identifies the client system from which the return request is received (e.g., Figure 1, reference numerals 101-110; Page 10, lines 7-16; Page 15, lines 5-21 Figure 5, reference numeral 510; Page 18, lines 10-20);

use the client identifier to identify the customer-specific return information (e.g., Figure 2, reference numerals 212, Page 14, line 31 through Page 15, line 21; Figure 5, reference numeral 510; Page 18, lines 11-17; Page 19, lines 4-12);

process the return in accordance with one or more return rules associated with the merchandise (e.g., Figures 6A-6B, reference numerals 558-588; Page 20, line 16 through Page 23, line 26); and

electronically notify the merchant of the return (e.g., Figure 5, reference numeral 567; Page 21, lines 11-19).

Grounds of Rejection to be Reviewed on Appeal

Are Claims 1-2, 4-7, 9, 11-15, 17, and 19-27 unpatentable under 35 U.S.C. § 103(a) over U.S. Patent No. 6,980,962 issued to Arganbright et al. ("*Arganbright*") in view U.S. Patent Application Publication No. 2002/0010634 issued to Roman et al. ("*Roman*") and further in view of U.S. Patent No. 6,246,997 issued to Cybul et al. ("*Cybul*")?

Arguments

Claims 1-2, 4-7, 9, 11-15, 17, and 19-27 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,980,962 issued to Arganbright et al. (*"Arganbright"*) in view U.S. Patent Application Publication No. 2002/0010634 issued to Roman et al. (*"Roman"*) and further in view of U.S. Patent No. 6,246,997 issued to Cybul et al. (*"Cybul"*). For at least the following reasons, Appellant respectfully submits that these rejections are improper and should be reversed by the Board. Appellant addresses independent Claims 1, 15, 17, 19-22, 24, and 26 and dependent Claims 6, 9, and 14 below.

I.   Legal Standard for Obviousness

The question raised under 35 U.S.C. § 103 is whether the prior art taken as a whole would suggest the claimed invention taken as a whole to one of ordinary skill in the art at the time of the invention. One of the three basic criteria that must be established by an Examiner to establish a *prima facie* case of obviousness is that "the prior art reference (or references when combined) must teach or suggest **all the claim limitations**." *See* M.P.E.P. § 706.02(j) citing *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991) (emphasis added). "*All words* in a claim must be considered in judging the patentability of that claim against the prior art." *See* M.P.E.P. § 2143.03 citing *In re Wilson*, 424 F.2d 1382, 1385 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970) (emphasis added).

In addition, even if all elements of a claim are disclosed in various prior art references, which is certainly not the case here as discussed below, the claimed invention taken as a whole still cannot be said to be obvious without some reason why one of ordinary skill at the time of the invention would have been prompted to modify the teachings of a reference or combine the teachings of multiple references to arrive at the claimed invention.

The controlling case law, rules, and guidelines repeatedly warn against using an Appellant's disclosure as a blueprint to reconstruct the claimed invention. For example, the M.P.E.P. states, "The tendency to resort to 'hindsight' based upon Appellant's disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art." M.P.E.P. § 2142.

The U.S. Supreme Court's decision in *KSR Int'l Co. v. Teleflex, Inc.* reiterated the requirement that Examiners provide an explanation as to why the claimed invention would have been obvious. *KSR Int'l Co. v. Teleflex, Inc.*, 127 S.Ct. 1727 (2007). The analysis regarding an apparent reason to combine the known elements in the fashion claimed in the patent at issue "should be made explicit." *KSR*, 127 S.Ct. at 1740-41. "Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *Id.* at 1741 (internal quotations omitted).

The new examination guidelines issued by the PTO in response to the *KSR* decision further emphasize the importance of an explicit, articulated reason why the claimed invention is obvious. Those guidelines state, in part, that "[t]he key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR* noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit." *Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in View of the Supreme Court Decision in KSR International Co. v. Teleflex Inc.*, 72 Fed. Reg. 57526, 57528-29 (Oct. 10, 2007) (internal citations omitted). The guidelines further describe a number of rationales that, in the PTO's view, can support a finding of obviousness. *Id.* at 57529-34. The guidelines set forth a number of particular findings of fact that must be made and explained by the Examiner to support a finding of obviousness based on one of those rationales. *See id.*

II. Claims 22-27 are Allowable over the *Arganbright-Roman-Cybul* Combination

In each of the Office Action mailed May 1, 2008, and the *Final Office Action* mailed November 20, 2008, the Examiner failed to provide an explicit rejection of Claim 22-27. Instead, the Examiner states that the limitations of Claims 22-27 "are similar to the limitations of Claims 1 and 25, therefore [Claims 22-27] are rejected based on the same rationale." (*Office Action*, page 6; *see also*, the Office Action mailed November 19, 2007, page 7). It has been and continues to be Appellant's position, however, that Claims 22-27 recite claim limitations that are distinct from Claims 1 and 25.

Appellant has repeatedly provided arguments explaining in detail the deficiencies of the cited references with regard to Claims 22-27. (*See*, Response to Office Action submitted on

January 22, 2008, pages 18-29; *see also,* Response to Office Action submitted on January 22, 2008, pages 16-18). Additionally, Appellant has repeatedly expressed disagreement with the Examiner's characterization of Claims 22-27 as being "similar to the limitations of Claims 1 and 25." (*See,* Response to Office Action submitted on January 22, 2008, pages 18-29). While the Examiner has changed the references used to reject Claims 22-27 in each Office Action, the Examiner continues to improperly group Claims 22-27 with Claims 1 and 25. Accordingly, the Examiner has failed to acknowledge the distinctions between Claims 22-27 and Claims 1 and 25. Appellant submits that the Office Action mailed May 1, 2008, and the *Final Office Action* mailed November 20, 2008, are incomplete and deficient on their faces for at least this reason.

Additionally, the Office Action mailed May 1, 2008, and the *Final Office Action* mailed November 20, 2008, are incomplete and deficient because the cited references, taken alone or in combination, do not disclose, teach, or suggest all the elements of Appellant's claims. For example, independent Claim 22 recites:

> A method of using a computer system for on-line processing of merchandise returns, comprising the steps of:
> in a first transaction associated with an online purchase of at least one item of merchandise, obtaining customer-specific return information from a customer associated with the at least one item of merchandise;
> *transmitting a client identifier to a client system associated with the customer;*
> *in a second transaction, receiving, via the Internet, a return request representing a request by the customer to initiate a return of at least one item of merchandise, the return request comprising the client identifier that uniquely identifies the client system from which the return request is received;*
> *using the client identifier to identify the customer-specific return information;*
> processing the return in accordance with one or more return rules associated with the merchandise; and
> electronically notifying a merchant of the return.

Because the proposed *Arganbright-Roman-Cybul* combination does not disclose, teach, or suggest at least the claim elements emphasized above, Appellant submits that the rejection of Claim 22 is improper and should be withdrawn. Because independent Claims 24 and 26 recite certain similar claim elements, Appellant submits that the rejections of Claims 24 and 26 are improper for analogous reasons and should also be withdrawn.

A.   **The proposed combination does not disclose, teach, or suggest *"transmitting a client identifier to a client system associated with the customer."***

As a first example of the deficiencies of the proposed *Arganbright-Roman-Cybul* combination, Appellant submits that the references do not disclose, teach, or suggest "transmitting a client identifier to a client system associated with the customer," as recited in Claim 22. *Arganbright*, which is cited as the primary reference, merely discloses "a system and method for providing complete electronic commerce ("E-Commerce") transactions and solutions for a marketing company's products via the World Wide Web." (Abstract). According to *Arganbright*, "an individual may register with the marketing system as a Client, a Member, or a Member Plus." (*Arganbright*, Column 2, lines 26-27). A client is eligible to buy products at a Client price, a member is eligible to buy products at a Member price, and a member plus is eligible to buy products at a Member Plus price. (*Arganbright*, Column 2, lines 27-32). Thus, the *Arganbright* system offers variable prices to customers based on the customer's status. According to *Arganbright*, "[a] client describes a participation category in which an individual registers with the marketing system." (*Arganbright*, Column 26, lines 48-49). As such *Arganbright* makes clear that "client" refers to the customer. It does not refer to a client system. For identifying the customer, *Arganbright* discloses "Member Sign-In," whereby the customer signs in "with a number assigned by the marketing company (IMC Number) and password from the primary navigation menu." (*Arganbright*, Column 42, lines 1-37). Thus, the customer is identified through a login process. *Arganbright* does not disclose, teach, or suggest "transmitting a client identifier to a client system associated with the customer," as recited in Claim 22.

The deficiencies of *Arganbright* are not cured by the additional disclosures of *Roman* and *Cybul*. *Roman* merely discloses that a customer is "asked a series of questions about the return" to obtain information "such as receipt number, consumer's name, phone number, description of the product being returned matching original transaction record collected from step above, condition of the product, such as original packaging and working condition." (*Roman*, Page 1, paragraph 0015). Thus, the customer is identified using information provided by the customer. Likewise, *Cybul* discloses a "authentication database" and a "frequent shopper identification," and, thus, is also limited to a system that identifies the customer by a number assigned to the customer. (*Cybul*, Column 2, lines 38-39; Column 1, lines 63-65),

Accordingly, like *Arganbright*, there is no disclosure in *Roman* or *Cybul* of "transmitting a client identifier to a client system associated with the customer," as recited in Claim 22.

For at least these reasons, Appellant respectfully requests reconsideration and allowance Claims 22, together with Claim 23 that depends on Claim 22. For analogous reasons, Appellant also requests reconsideration and allowance of independent Claims 24 and 26, together with Claims 25 and 27 that depend on Claims 24 and 26, respectively.

B.   The proposed combination does not disclose, teach, or suggest "*in a second transaction, receiving, via the Internet, a return request representing a request by the customer to initiate a return of at least one item of merchandise, the return request comprising the client identifier that uniquely identifies the client system from which the return request is received.*"

As a second example of the deficiencies of the proposed *Arganbright-Roman-Cybul* combination, Appellant submits that the references do not disclose, teach, or suggest "in a second transaction, receiving, via the Internet, a return request representing a request by the customer to initiate a return of at least one item of merchandise, the return request comprising the client identifier that uniquely identifies the client system from which the return request is received," as recited in Claim 22. As noted above, *Arganbright* discloses "Member Sign-In," whereby the customer signs in "with a number assigned by the marketing company (IMC Number) and password from the primary navigation menu." (*Arganbright*, Column 42, lines 1-37). Thus, the customer is identified through a login process. To the extent that *Arganbright* discloses a return process, there is no disclosure that the return request includes a client identifier that uniquely identifies the client system. Rather, *Arganbright* discloses that "[a]fter the user has a chance to review satisfaction guarantee 2702, the user selects whether the user wishes to "return" or "exchange" (box 2704) an item or plurality of items." (Column 63, lines 8-11). Thereafter, *Arganbright* discloses that a "[t]he user is then requested to enter a plurality of information (box 2708) on return form 2706, including but not limited to, quantity, stock number or SKU, the reason for the return, product description, and an invoice number." (Column 63, lines 13-17, emphasis added). Because *Arganbright* discloses that the customer is identified by a login process and by information provided by the customer (and because *Arganbright* makes no mention of identifying a client system), *Arganbright* does not disclose, teach, or suggest "in a second transaction, receiving, via the Internet, a return request

representing a request by the customer to initiate a return of at least one item of merchandise, the return request comprising the client identifier that uniquely identifies the client system from which the return request is received," as recited in Claim 22. At least these elements are absent from the disclosure of *Arganbright*.

The deficiencies of *Arganbright* are not cured by the additional disclosures of *Roman* and *Cybul*. *Roman* merely discloses that a customer is "asked a series of questions about the return" to obtain information "such as receipt number, consumer's name, phone number, description of the product being returned matching original transaction record collected from step above, condition of the product, such as original packaging and working condition." (*Roman*, Page 1, paragraph 0015). Thus, the customer is identified using information provided by the customer. Likewise, *Cybul* discloses a "authentication database" and a "frequent shopper identification," and, thus, is also limited to a system that identifies the customer by a number assigned to the customer. (*Cybul*, Column 2, lines 38-39; Column 1, lines 63-65), Accordingly, like *Arganbright*, there is no disclosure in *Roman* or *Cybul* of "in a second transaction, receiving, via the Internet, a return request representing a request by the customer to initiate a return of at least one item of merchandise, the return request comprising the client identifier that uniquely identifies the client system from which the return request is received," as recited in Claim 22.

For at least these additional reasons, Appellant respectfully requests reconsideration and allowance Claims 22, together with Claim 23 that depends on Claim 22. For analogous reasons, Appellant also requests reconsideration and allowance of independent Claims 24 and 26, together with Claims 25 and 27 that depend on Claims 24 and 26, respectively.

C. The proposed combination does not disclose, teach, or suggest *"using the client identifier to identify the customer-specific return information."*

As a third example of the deficiencies of the proposed *Arganbright-Roman-Cybul* combination, Appellant submits that the references do not disclose, teach, or suggest "using the client identifier to identify the customer-specific return information," as recited in Claim 22. As noted above, *Arganbright* discloses "Member Sign-In," whereby the customer signs in "with a number assigned by the marketing company (IMC Number) and password from the primary navigation menu." (*Arganbright*, Column 42, lines 1-37). Thus, the customer is identified through a login process. To the extent that *Arganbright* discloses a return process,

there is no disclosure that the return request includes a client identifier associated with a client system. Rather, *Arganbright* discloses that "[a]fter the user has a chance to review satisfaction guarantee 2702, the user selects whether the user wishes to "return" or "exchange" (box 2704) an item or plurality of items." (Column 63, lines 8-11). Thereafter, *Arganbright* discloses that a "[t]he user is then requested to enter a plurality of information (box 2708) on return form 2706, including but not limited to, quantity, stock number or SKU, the reason for the return, product description, and an invoice number." (Column 63, lines 13-17, emphasis added). Because *Arganbright* discloses that the customer is identified by a login process and that return information is provided by the customer (and because *Arganbright* makes no mention of identifying a client system), *Arganbright* does not disclose, teach, or suggest "using the client identifier to identify the customer-specific return information," as recited in Claim 22. At least these elements are absent from the disclosure of *Arganbright*.

Again, the deficiencies of *Arganbright* are not cured by the additional disclosures of *Roman* and *Cybul*. *Roman* merely discloses that a customer is "asked a series of questions about the return" to obtain information "such as receipt number, consumer's name, phone number, description of the product being returned matching original transaction record collected from step above, condition of the product, such as original packaging and working condition." (*Roman*, Page 1, paragraph 0015). Thus, the customer is identified using information provided by the customer. Likewise, *Cybul* discloses a "authentication database" and a "frequent shopper identification," and, thus, is also limited to a system that identifies the customer by a number assigned to the customer. (*Cybul*, Column 2, lines 38-39; Column 1, lines 63-65), Accordingly, like *Arganbright*, there is no disclosure in *Roman* or *Cybul* of "using the client identifier to identify the customer-specific return information," as recited in Claim 22.

For at least these reasons, Appellant respectfully requests reconsideration and allowance Claims 22, together with Claim 23 that depends on Claim 22. For analogous reasons, Appellant also requests reconsideration and allowance of independent Claims 24 and 26, together with Claims 25 and 27 that depend on Claims 24 and 26, respectively.

III. **Claims 1, 2, 7, 11-12, 14-15, 17, and 19-21 are Allowable over the *Arganbright-Roman-Cybul* Combination**

The *Final Office Action* is deficient at least because the cited references, taken alone or in combination, do not disclose, teach, or suggest all the elements of Appellant's Claims 1, 2, 6, 7, 11-15, 17, and 19-21. For example, independent Claim 1 of the present Application, as amended, recites:

> A method of using a computer system for on-line processing of merchandise returns for a plurality of merchants, comprising the steps of:
> storing a set of return rules in a database for each of the plurality of merchants;
> receiving, via the Internet, a return request representing a request by a customer to initiate a return of at least one item of merchandise;
> *in response to receiving the return request from the customer, gathering transaction history data associated with the customer from a computerized database;*
> displaying the transaction history to the customer for selection of a particular item of merchandise within a listing of merchandise included in the transaction history;
> *receiving, from a customer, an electronic selection by a click on the at least one item of merchandise in the displayed listing of merchandise, the electronic selection identifying the at least one item of merchandise for returns processing;*
> *in response to receiving the click on the at least one item of merchandise in the listing of merchandise, using the set of return rules associated with the identified merchant and the transaction information to validate the return;*
> upon validating the return, electronically delivering data about the customer to the merchant associated with the return;
> processing the return in accordance with the set of return rules associated with the merchant.

Because the proposed *Arganbright-Roman-Cybul* combination does not disclose, teach, or suggest at least the claim elements emphasized above, Appellant submits that the rejection of Claim 1 is improper and should be withdrawn. Because independent Claims 15, 17, and 19-21 recite certain similar claim elements, Appellant submits that the rejections of Claims 15, 17, and 19-21 are improper for analogous reasons and should also be withdrawn.

A.   The proposed combination does not disclose, teach, or suggest *"receiving, from a customer, an electronic selection by a click on the at least one item of merchandise in the displayed listing of merchandise, the electronic selection identifying the at least one item of merchandise for returns processing."*

As a first example of the deficiencies of the *Arganbright-Roman-Cybul* combination, Appellant respectfully submits that the cited references do not disclose, teach, or suggest "receiving, from a customer, an electronic selection by a click on the at least one item of merchandise in the displayed listing of merchandise, the electronic selection identifying the at least one item of merchandise for returns processing," as recited in Claim 1. *Arganbright* merely discloses that "[a]fter the user has a chance to review satisfaction guarantee 2702, the user selects whether the user wishes to "return" or "exchange" (box 2704) an item or plurality of items." (Column 63, lines 8-11). Thus, to the extent that *Arganbright* discloses a user selection, such user selection is of either a "return" button or an "exchange" button. Thereafter, *Arganbright* discloses that a "[t]he user is then requested to enter a plurality of information (box 2708) on return form 2706, including but not limited to, quantity, stock number or SKU, the reason for the return, product description, and an invoice number." (Column 63, lines 13-17, emphasis added). Appellant respectfully contends that the selection of a "return" button followed by the population of a form by the user is not analogous to "receiving, from a customer, an electronic selection by a click on the at least one item of merchandise in the displayed listing of merchandise, the electronic selection identifying the at least one item of merchandise for returns processing," as recited in Claim 1.

Appellant notes that *Arganbright* discloses "a user accessing a link to view order history details." (*Office Action*, page 2, citing Column 2, lines 43-45 of *Arganbright*). The cited portion of *Arganbright* merely discloses, however, that an e-mail notification received by the customer may include "a link that allows the user to view order history details." (Column 2, lines 43-45). There is no disclosure in *Arganbright*, however, that such order history details are displayed to the customer in a returns context or that an item included in the order history details may be clicked-on or otherwise selected. Appellant respectfully submits that providing a link to order history details so that they may be viewed by a customer is not analogous to "receiving, from a customer, an electronic selection by a click on the at least one item of merchandise in the displayed listing of merchandise, the electronic selection identifying the at least one item of merchandise for returns processing," as recited in Appellant's Claim 1.

Roman does not cure the deficiencies of *Arganbright*. Like *Arganbright*, *Roman* discloses a return system in which the consumer "clicks on "return" or "Customer Service" selection. (*Roman*, page 1, paragraph 14). According to *Roman*, the consumer "is then asked a series of questions about the return." (*Roman*, page 1, paragraph 15). Specifically, the consumer is asked for information "such as receipt number, consumer's name, phone number, description of the product being returned matching original transaction record collected from step above, condition of the product, such as original packaging and working condition." (*Roman*, page 1, paragraph 15). Again, for reasons analogous to those discussed above with regard to *Arganbright*, Appellant respectfully contends that the selection of a "return" button followed by the provision of information from the user is not analogous to "receiving, from a customer, an electronic selection by a click on the at least one item of merchandise in the displayed listing of merchandise, the electronic selection identifying the at least one item of merchandise for returns processing," as recited in Claim 1.

Even when considered in conjunction with the disclosure of *Cybul*, Appellant's claim language would not have been obvious to one of ordinary skill in the art. *Cybul* relates to a system for online shopping that "takes advantage of the data already being gathered by POS systems on consumer shopping habits and preferences." (*Cybul*, Column 1, lines 36-38). Specifically, *Cybul* discloses that where a vendor's POS system "supports a frequent shopper or loyalty program . . . [or]a database of historical purchase data indexed by loyalty customer," the information may be extracted from the vendor's POS system. (*Cybul*, Column 4, lines 25-34; Column 1, lines 63-65). As a result, a list builder tool can "efficiently find and select the past shopping history of respective shoppers and import that data to the list builder's on-line historical purchase list database, thereby making it available for the shoppers' first and subsequent on-line shopping experiences." (*Cybul*, Column 4, lines 29-34). As such, *Cybul* merely discloses that a shopper's purchases in a brick-and-mortar store are used to develop an online shopping list for that shopper's subsequent purchases on-line.

Accordingly, at most, the *Arganbright-Roman-Cybul* combination discloses that during an online purchase, a customer's in store purchases may be used to efficiently develop an on-line shopping list. If an item were needed to be returned after the purchase is complete, the proposed combination merely discloses that a return form could be obtained on-line and filled out by the customer on the customer's computer. The form would then be printed and placed in the box for shipping, as suggested by *Arganbright*. It would not have been obvious to one of

ordinary skill in the art to modify the return process of *Arganbright* and the purchase process of *Cybul* to result in Appellant's recited step of "receiving, from a customer, an electronic selection by a click on the at least one item of merchandise in the displayed listing of merchandise, the electronic selection identifying the at least one item of merchandise for returns processing," as recited in Claim 1.

For at least these reasons, Appellant respectfully requests reconsideration and allowance Claims 1, together with Claims 2, 4-5, 7, and 11-13 that depend on Claim 1. For analogous reasons, Appellant also requests reconsideration and allowance of independent Claims 15, 17, and 19-21 together with Claim 16 that depends on Claim 15.

B.   The proposed combination does not disclose, teach, or suggest *"in response to receiving the click on the at least one item of merchandise in the listing of merchandise, using the set of return rules associated with the identified merchant and the transaction information to validate the return."*

As a second example of the deficiencies of the *Arganbright-Roman-Cybul* combination, Appellant's Claim 1 further recites "in response to receiving the click on the at least one item of merchandise in the listing of merchandise, using the set of return rules associated with the identified merchant and the transaction information to validate the return." Thus, Appellant's claim recites a specific order to the steps of the claimed method. First, a click on a particular item of merchandise is received. Then, in response to the click on the item in the displayed listing, a set of return rules is used to validate the return. Appellant respectfully submits that the proposed *Arganbright-Roman-Cybul* combination does not disclose, teach, or suggest the features and operations recited in Appellant's claim.

In the *Office Action*, the Examiner relies specifically on *Roman* for disclosure of Appellant's recited step. However, *Roman* merely discloses a return system in which the consumer "clicks on "return" or "Customer Service" selection. (*Roman*, page 1, paragraph 14). According to *Roman*, the consumer "is then asked a series of questions about the return." (*Roman*, page 1, paragraph 15). Specifically, the consumer is asked for information "such as receipt number, consumer's name, phone number, description of the product being returned matching original transaction record collected from step above, condition of the product, such as original packaging and working condition." (*Roman*, page 1, paragraph 15). There is no disclosure in *Roman* of system in which a transaction history is displayed to a customer that

allows a customer to click on a particular item of merchandise within a listing of merchandise. Likewise, there is no disclosure in *Roman* of receiving a click on a particular item of merchandise. Because *Roman* does not disclose receiving a click on an item of merchandise, *Roman* cannot be said to disclose, teach, or suggest using the set of return rules associated with the identified merchant and the transaction information to validate the return "**in response to receiving the click on the at least one item of merchandise in the listing of merchandise**," as recited in Appellant's Claim 1.

For at least these reasons, Appellant respectfully requests reconsideration and allowance Claims 1, together with Claims 2, 4-5, 7, and 11-13 that depend on Claim 1. For analogous reasons, Appellant also requests reconsideration and allowance of independent Claims 15, 17, and 19-21 together with Claim 16 that depends on Claim 15.

C.   **The proposed combination does not disclose, teach, or suggest "*in response to receiving the return request from the customer, gathering transaction history data associated with the customer from a computerized database.*"**

As a third example of the deficiencies of the *Arganbright-Roman-Cybul* combination, Appellant's Claim 1 recites "in response to receiving the return request from the customer, gathering transaction history data associated with the customer from a computerized database." Thus, Appellant's claim recites a specific order to the steps of the claimed method. First, a return request is received via the Internet. Then, in response to that return request, transaction history data associated with the customer is gathered from a computerized database. Appellant respectfully submits that the proposed *Arganbright-Roman-Cybul* combination does not disclose, teach, or suggest the features and operations recited in Appellant's claim.

In the *Office Action*, the Examiner acknowledges that *Arganbright* and *Roman* do not disclose the recited claim elements and instead relies upon *Cybul*, specifically, for disclosure of the recited claim elements. (*Office Action*, pages 3-4). Appellant respectfully disagrees. *Cybul* relates to a system for online shopping that "takes advantage of the data already being gathered by POS systems on consumer shopping habits and preferences." (*Cybul*, Column 1, lines 36-38). Specifically, *Cybul* discloses that where a vendor's POS system "supports a frequent shopper or loyalty program . . . [or]a database of historical purchase data indexed by loyalty customer," the information may be extracted from the vendor's POS system. (*Cybul*, Column 4, lines 25-34; Column 1, lines 63-65; Abstract). As a result, a list builder tool can "efficiently

find and select the past shopping history of respective shoppers and import that data to the list builder's on-line historical purchase list database, thereby making it available for the shoppers' first and subsequent on-line shopping experiences." (*Cybul*, Column 4, lines 29-34; Abstract). As such, *Cybul* merely discloses that a shopper's purchases in a brick-and-mortar store are used to develop an online shopping list for that shopper's subsequent purchases on-line. *Cybul* does not at all relate to a returns process and, thus, does not disclose, teach, or suggest gathering transaction history data associated with the customer from a computerized database "*in response to receiving the return request from the customer.*"

For at least these reasons, Appellant respectfully requests reconsideration and allowance Claims 1, together with Claims 2, 4-5, 7, and 11-13 that depend on Claim 1. For analogous reasons, Appellant also requests reconsideration and allowance of independent Claims 15, 17, and 19-21 together with Claim 16 that depends on Claim 15.

IV.   Claim 6 is Allowable over the *Arganbright-Roman-Cybul* Combination

Dependent Claim 6 depends upon independent Claim 1, which Appellant has shown above to be allowable. Accordingly, dependent Claim 6 is not obvious over the proposed combination of references at least because Claim 6 includes the limitations of independent Claim 1. Additionally, the *Final Office Action* is further deficient because the cited references, taken alone or in combination, do not disclose, teach, or suggest all the elements of Appellant's dependent Claim 6.

For example, the proposed *Arganbright-Roman-Cybul* combination does not disclose, teach, or suggest that the step of "processing the return in accordance with the set of return rules associated with the merchant" is performed "by determining disposition of the item," as recited in Claim 6. In the *Final Office Action*, the Examiner relies upon *Arganbright*, specifically, for disclosure of the recited claim elements. (*Final Office Action*, page 5). *Arganbright* merely discloses, however, that "the system presents the user with a copy of the satisfaction guarantee 2702." (*Arganbright*, Column 63, lines 3-5). According to *Arganbright*, "[a]fter the user has a chance to review satisfaction guarantee 2702, the user selects whether the user wishes to "return" or "exchange" (box 2704) an item or plurality of items." (*Arganbright*, Column 63, lines 8-11). Thus, *Arganbright* merely discloses a selection made by a user of either a "return" button or an "exchange" button. Although a

shipping label may be provided, *Arganbright* only discloses that the product is "to be returned to the marketing company." (*Arganbright*, Column 63, lines 29-35). There is no disclosure in *Arganbright* of "a set of return rules associated with the merchant" or of "processing the return in accordance with the set of return rules associated with the merchant [. . .] by determining disposition of the item," as recited in Claim 6.

For at least these reasons, Appellant respectfully requests reconsideration and allowance Claim 6.

V.   Claim 14 is Allowable over the *Arganbright-Roman-Cybul* Combination

Dependent Claim 14 depends independ ent Claim 1, which Appellant has shown above to be allowable. Accordingly, dependent Claim 14 is not obvious over the proposed combination of references at least because Claim 14 includes the limitations of independent Claim 1. Additionally, the *Final Office Action* is further deficient because the cited references, taken alone or in combination, do not disclose, teach, or suggest all the elements of Appellant's dependent Claim 14.

For example, the proposed *Arganbright-Roman-Cybul* combination does not disclose, teach, or suggest that the step of "notifying a shipping agent of the return," as recited in Claim 14. In the *Final Office Action*, the Examiner relies upon *Arganbright*, specifically, for disclosure of the recited claim elements. (*Final Office Action*, page 6). *Arganbright* merely discloses, however, that once the user accepts the return from, it may be "presented to the user in a format (box 2710) that can be printed on a conventional printer connected to the user's computer, for example." (*Arganbright*, Column 63, lines 23-27). Thereafter, the user may "print the form and include the form in the box containing the product or products to be returned." (*Arganbright*, Column 63, lines 27-29). The user also prints "a pre-paid postage label and include[s] it with the package of products to be returned to the marketing company." Thus, while *Arganbright* discloses the provision and printing of a shipping label that may be used to ship something via the United States Postal Service (*Arganbright*, Column 63, lines 29-31), *Arganbright* does not disclose "notifying" the United States Postal Service or other shipping agent of the pending return. (*Arganbright*, Column 63, lines 8-11).

Accordingly, *Arganbright* does not disclose, teach, or suggest "notifying a shipping agent of the return," as recited in Claim 14.

For at least these reasons, Appellant respectfully requests reconsideration and allowance Claim 14.

VI.   Claim 9 is Allowable over the *Arganbright-Roman-Cybul* Combination

Dependent Claim 9 depends upon independent Claim 1, which Appellant has shown above to be allowable. Accordingly, dependent Claim 9 is not obvious over the proposed combination of references at least because Claim 9 includes the limitations of independent Claim 1. Additionally, the *Final Office Action* is further deficient because the cited references, taken alone or in combination, do not disclose, teach, or suggest all the elements of Appellant's dependent Claim 9.

For example, the proposed *Arganbright-Roman-Cybul* combination does not disclose, teach, or suggest that the step of "processing the return in accordance with the set of return rules associated with the merchant" is performed "by crediting an account of the customer," as recited in Claim 9. In the *Final Office Action*, the Examiner identifies no reference as specifically disclosing the recited claim elements and instead takes Official Notice that the claim elements are well known and old in the art. (*Final Office Action*, page 5). Appellant traverses the Examiner's taking of Official Notice.

The M.P.E.P. states that Official Notice is <u>only</u> appropriate "provided the facts so noticed are of notorious character and serve only to "fill in t he gaps" which might exist in the evidentiary showing made by the examiner to support a particular ground of rejection." (M.P.E.P., § 2144.03, citing *In re Zurko*, 258 F.3d 1379, 1385, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001); *Ahlert*, 424 F.2d at 1092, 165 U.S.P.Q at 421). Such is not the case here. The recited claim elements do not "fill in the gaps" of *Arganbright, Roman*, and *Cybul*. Additionally, the Examiner has provided no evidence to support the Examiner's contention that Appellant's customer information comprising "the processing step is performed by crediting an account of the customer," as recited in Appellant's dependent Claim 9, is indeed "old and well known" in the art. In this case, it would <u>not</u> be appropriate for the examiner to take official notice of the claim elements of Claim 9 without citing a prior art reference

where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known. (M.P.E.P. § 2144.03).

For at least these reasons, Appellant respectfully requests reconsideration and allowance Claim 9.

VII. The *Arganbright-Roman-Cybul* Combination is Improper as Applied to Appellant's Claims

Furthermore, Appellant submits that the Examiner has not presented a legally sufficient argument demonstrating a motivation to combine *Arganbright*, *Roman*, and *Cybul*.

According to the M.P.E.P., in order "[t]o establish a prima facie case of obviousness . . . there must be some suggestion or motivation either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings." See §2143. Notably absent from this list is an allowance for an Examiner's conjectured assertion as to the motivation to combine reference teachings. A quote from the M.P.E.P. is directed specifically to this point: "[t]he examiner and the board asserted that it would have been within the skill of the art to substitute one type of detector for another in the system of the primary reference, however the court found there was **no support or explanation** of this conclusion and reversed." See §2143.01 (I) (emphasis added). Thus, "the proper inquiry is whether there is something in the prior art as a whole to suggest the *desirability* . . . of making the combination." *Id.* (internal quotations omitted) (emphasis original). "The mere fact that the references <u>can</u> be combined or modified does not render the resultant combination obvious unless the prior art also suggests the **desirability** of the combination." See §2143.01 (III) (emphasis original and added). Most recently, this requirement has been reaffirmed in an official USPTO memorandum dated May 3, 2007 wherein the Deputy Commissioner for Patent Operations pointed to sections of *KSR v. Teleflex*, which recite, "it will be necessary . . . to determine whether there was an **apparent reason** to combine the known elements in the fashion claimed by the patent at issue." *KSR Int'l. Co v. Teleflex Inc.*, No. 04-1350 (April 30, 2007) (emphasis added).

As applied to the present application, the *Final Office Action* has failed to meet this burden because the Examiner has not shown "something in the prior art as a whole to suggest the *desirability*" of combining *Arganbright*, *Roman*, and *Cybul*, but rather seems to rely on a

conjectured assertion that "the references <u>can</u> be combined" without regard to the "desirability of the combination." This directly conflicts with the M.P.E.P. requirements for supporting a motivation to combine references. Specifically, the Examiner only states "it would have been obvious . . . to incorporate the teachings of *Roman* into the disclosure of *Arganbright* in order to prevent the invalid return of merchandise." (*Final Office Action*, page 3). Additionally, the Examiner states that "it would have been obvious . . . to incorporate the teachings of *Cybul* into the disclosure of *Arganbright* in view of *Roman* in order to provide the consumer with the option to return items via internet or online." (*Final Office Action*, page 4). These bald assertions do not meet the requirements of the M.P.E.P. The Examiner did not provide "support or explanation" for the motivation to make the proposed combinations nor did the Examiner show any "desirability" of doing so. Instead, the Examiner seems to base this assertion on pure conjecture. The alleged advantages provided by the Examiner do not provide an explanation as to: (1) why it would have been obvious to one of ordinary skill in the art at the time of Appellant's invention *without using Appellants' claims as a guide* to modify the particular techniques disclosed in *Arganbright* with the cited disclosures in *Roman* and *Cybul*; (2) how one of ordinary skill in the art at the time of Applicants' invention would have actually done so; and (3) how doing so would purportedly meet the limitations of Claim 1. Indeed, if it were sufficient for Examiners to merely point to a purported advantage of one reference and conclude that it would have been obvious to combine of modify that reference with other references simply based on that advantage (which, as should be evident from the case law discussed above, it certainly is not), then virtually any two or more references would be combinable just based on the fact the one reference states an advantage of its system. Of course, as the Federal Circuit has made clear and as discussed above, that is not the law.

For at least these reasons, Appellant requests that the rejections of the present claims be withdrawn for want of a *prima facie* showing of obviousness as defined by the M.P.E.P. and for the various other reasons described above.
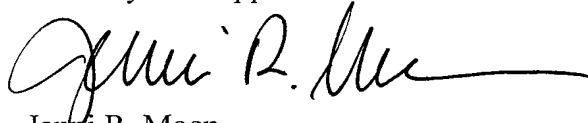
CONCLUSION

Appellant has demonstrated that the present invention, as claimed, is clearly distinguishable over the prior art cited by the Examiner. Therefore, Appellant respectfully requests the Board to reverse the final rejections and instruct the Examiner to issue a Notice of Allowance with respect to all pending claims.

The Commissioner is hereby authorized to charge $270.00 for filing this Brief in support of an Appeal to Deposit Account No. 02-0384 of Baker Botts, L.L.P. No other fees are believed due; however, the Commissioner is authorized to charge any additional fees or credits to Deposit Account No. 02-0384 of Baker Botts, L.L.P.

Respectfully submitted,

BAKER BOTTS L.L.P.
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APPENDIX A

Pending Claims

1.   (Previously Presented) A method of using a computer system for on-line processing of merchandise returns for a plurality of merchants, comprising the steps of:

storing a set of return rules in a database for each of the plurality of merchants;

receiving, via the Internet, a return request representing a request by a customer to initiate a return of at least one item of merchandise;

in response to receiving the return request from the customer, gathering transaction history data associated with the customer from a computerized database;

displaying the transaction history to the customer for selection of a particular item of merchandise within a listing of merchandise included in the transaction history;

receiving, from a customer, an electronic selection by a click on the particular item of merchandise in the displayed listing of merchandise, the electronic selection identifying the particular item of merchandise for returns processing;

in response to receiving the click on the particular item of merchandise in the listing of merchandise, using the set of return rules associated with the identified merchant and the transaction information to validate the return;

upon validating the return, electronically delivering data about the customer to the merchant associated with the return;

processing the return in accordance with the set of return rules associated with the merchant.

2.   (Original) The method of Claim 1, wherein the receiving step is performed via an Internet access tool associated with the customer.

4.   (Original) The method of Claim 1, wherein the processing step is performed by determining if the return is valid.

5.   (Original) The method of Claim 4, further comprising step of notifying the customer, via the Internet, whether the return is valid.

6.   (Original) The method of Claim 1, wherein the processing step is performed by determining disposition of the item.

7. (Original) The method of Claim 1, wherein the processing step is performed by determining a shipping destination of the item.

9. (Original) The method of Claim 1, wherein the processing step is performed by crediting an account of the customer.

11. (Original) The method of Claim 1, further comprising the step of providing a user interface to the customer, via an Internet access tool, wherein the user interface displays information associated with return of one or more items purchased by the customer.

12. (Original) The method of Claim 11, wherein the user interface displays a list of transactions associated with the customer, listing items for potential return by the customer.

13. (Original) The method of Claim 1, further comprising the step of downloading a return label to the customer via the Internet.

14. (Original) The method of Claim 1, further comprising the step of notifying a shipping agent of the return.

15.   (Previously Presented)   An on-line merchandise return system for processing merchandise returns for a plurality of merchants, comprising a computer system programmed to:

store a set of return rules in a database for each of the plurality of merchants;

receive a return request, via the Internet, representing a request by a customer to initiate a return at least one item of merchandise;

in response to receiving the return request from the customer, gather transaction history data associated with the customer from a computerized database;

display the transaction history to the customer for selection of a particular item of merchandise within a listing of merchandise included in the transaction history;

receive, from a customer, an electronic selection by a click on the particular item of merchandise in the displayed listing of merchandise, the electronic selection identifying the particular item of merchandise for returns processing;

in response to receiving the click on the particular item of merchandise in the listing of merchandise, use the set of return rules associated with the identified merchant and the transaction information to validate the return;

upon validating the return, electronically deliver data about the customer to the merchant associated with the return; and

process the return in accordance with the set of return rules associated with the merchant.

17. (Previously Presented) Software for facilitating online merchandise return services, the software embodied in a computer-readable medium and when executed operable to:

store a set of return rules in a database for each of the plurality of merchants;

receive, via the Internet, a return request representing a request by a customer to initiate a return of at least one item of merchandise;

in response to receiving the return request from the customer, gather transaction history data associated with the customer from a computerized database;

display the transaction history to the customer for selection of a particular item of merchandise within a listing of merchandise included in the transaction history;

receive, from a customer, an electronic selection by a click on the particular item of merchandise in the displayed listing of merchandise, the electronic selection identifying the particular item of merchandise for returns processing;

in response to receiving the click on the particular item of merchandise in the listing of merchandise, use the set of return rules associated with the identified merchant and the transaction information to validate the return;

upon validating the return, electronically deliver data about the customer to the merchant associated with the return; and

process the return in accordance with the set of return rules associated with the merchant.

19.   (Previously Presented) A method of using a computer for online merchandise returns, comprising the steps of:

receiving, from each of a plurality of merchants, a set of return rules representing merchandise return policies of each merchant;

storing the return rules in a database;

receiving, via the Internet, a return request representing a request by a customer to initiate a return of at least one item of merchandise;

in response to receiving the return request from the customer, gathering transaction history data associated with the customer from a computerized database;

displaying the transaction history to the customer for selection of a particular item of merchandise within a listing of merchandise included in the transaction history;

receiving, from a customer, an electronic selection by a click on the particular item of merchandise in the displayed listing of merchandise, the electronic selection identifying the particular item of merchandise for returns processing;

in response to receiving the click on the particular item of merchandise in the listing of merchandise, using the set of return rules associated with the identified merchant to validate the return;

upon validating the return, processing the return in accordance with the set of return rules associated with the merchant.

20. (Previously Presented) An on-line merchandise return system for processing merchandise returns for a plurality of merchants, comprising a computer system programmed to:

receive, from each of a plurality of merchants, a set of return rules representing merchandise return policies of each merchant;

store the return rules in a database;

receive, via the Internet, a return request representing a request by a customer to initiate a return of at least one item of merchandise;

in response to receiving the return request from the customer, gather transaction history data associated with the customer from a computerized database;

display the transaction history to the customer for selection of a particular item of merchandise within a listing of merchandise included in the transaction history;

receive, from a customer, an electronic selection by a click on the particular item of merchandise in the displayed listing of merchandise, the electronic selection identifying the particular item of merchandise for returns processing;

in response to receiving the click on the particular item of merchandise in the listing of merchandise, use the set of return rules associated with the identified merchant to validate the return;

upon validating the return, process the return in accordance with the set of return rules associated with the merchant.

21.   (Previously Presented)   Software for facilitating online merchandise return services for a plurality of merchants, the software embodied in a computer-readable medium and when executed operable to:

receive, from each of a plurality of merchants, a set of return rules representing merchandise return policies of each merchant;

store the return rules in a database;

receive, via the Internet, a return request representing a request by a customer to initiate a return of at least one item of merchandise;

in response to receiving the return request from the customer, gather transaction history data associated with the customer from a computerized database;

display the transaction history to the customer for selection of a particular item of merchandise within a listing of merchandise included in the transaction history;

receive, from a customer, an electronic selection by a click on the particular item of merchandise in the displayed listing of merchandise, the electronic selection identifying the particular item of merchandise for returns processing;

in response to receiving the click on the particular item of merchandise in the listing of merchandise, use the set of return rules associated with the identified merchant to validate the return;

upon validating the return, process the return in accordance with the set of return rules associated with the merchant.

22. (Previously Presented) A method of using a computer system for on-line processing of merchandise returns, comprising the steps of:

in a first transaction associated with an online purchase of at least one item of merchandise, obtaining customer-specific return information from a customer associated with the at least one item of merchandise;

transmitting a client identifier to a client system associated with the customer;

in a second transaction, receiving, via the Internet, a return request representing a request by the customer to initiate a return of at least one item of merchandise, the return request comprising the client identifier that uniquely identifies the client system from which the return request is received;

using the client identifier to identify the customer-specific return information;

processing the return in accordance with one or more return rules associated with the merchandise; and

electronically notifying a merchant of the return.

23. (Original) The method of Claim 22, further comprising the step of electronically providing the merchant with information about the customer.

24. (Previously Presented) An on-line merchandise return system, comprising a computer system programmed to:

in a first transaction associated with an online purchase of at least one item of merchandise, obtain customer-specific return information from a customer associated with the at least one item of merchandise;

transmit a client identifier to a client system associated with the customer;

in a second transaction, receive, via the Internet, a return request representing a request by the customer to initiate a return of at least one item of merchandise, the return request comprising the client identifier that uniquely identifies the client system from which the return request is received;

use the client identifier to identify the customer-specific return information;

process the return in accordance with one or more return rules associated with the merchandise; and

electronically notify the merchant of the return.

25. (Original) The method of Claim 24, wherein the system is further programmed to electronically provide the merchant with information about the customer.

26. (Previously Presented) Software for facilitating online merchandise return services, the software embodied in a computer-readable medium and when executed operable to:

in a first transaction associated with an online purchase of at least one item of merchandise, obtain customer-specific return information from a customer associated with the at least one item of merchandise;

transmit a client identifier to a client system associated with the customer;

in a second transaction, receive, via the Internet, a return request representing a request by the customer to initiate a return of at least one item of merchandise, the return request comprising the client identifier that uniquely identifies the client system from which the return request is received;

use the client identifier to identify the customer-specific return information;

process the return in accordance with one or more return rules associated with the merchandise; and

electronically notify the merchant of the return.

27. (Previously Presented) The software of Claim 26, further operable to electronically provide the merchant with information about the customer.

APPENDIX B

Evidence Appendix

Other than the references attached to this Appeal Brief as Appendices A and B, no evidence was submitted pursuant to 37 C.F.R. §§ 1.130, 1.131, or 1.132, and no other evidence was entered by the Examiner and relied upon by Appellant in the Appeal.

APPENDIX C

Related Proceedings Appendix

As stated on Page 3 of this Appeal Brief, United States Patent Application Serial No. 09/817,353 and United States Patent Application Serial No. 10/751,216 are under appeal and may be related to or affect the bearing on the Board's decision in this Appeal. Accordingly, copies of the Appeal Briefs for these pending Applications are attached.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
ON APPEAL FROM THE EXAMINER TO THE BOARD
OF PATENT APPEALS AND INTERFERENCES

In re Application of:	Philip S. Siegel
Serial No.:	09/817,353
Filing Date:	March 26, 2001
Group Art Unit:	3627
Examiner:	Mussa A. Shaawat
Confirmation No.:	4525
Title:	SYSTEM AND METHOD FOR SINGLE-ACTION RETURNS OF REMOTELY PURCHASED MERCHANDISE

MAIL STOP APPEAL BRIEF - PATENTS
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Dear Sir:

APPEAL BRIEF

Appellant has appealed to the Board of Patent Appeals and Interferences ("Board") from the Final Office Action dated November 19, 2008. Appellant filed a Notice of Appeal on February 19, 2009 with the statutory fee of $270.00. This Appeal Brief is filed in response to the Advisory Action dated February 4, 2009, finally rejecting Claims 1-9 and 35-46 of claims 1-46 pending in this Application.

Real Party In Interest

This Application is currently owned by Newgistics, Inc. as indicated by:

an assignment recorded on 05/19/00 from inventor Philip S. Siegel to Ireturnit, Inc., in the Assignment Records of the PTO at Reel 010843, Frame 0601 (3 pages); and

an assignment recorded on 8/21/01 from Ireturnit, Inc. to Newgistics, Inc., in the Assignment Records of the PTO at Reel 012095, Frame 0287 (3 pages).

Related Appeals and Interferences

Applicant directs the Board's attention to following pending Applications that are under appeal and may be related to or affect the bearing on the Board's decision in this Appeal:

1.   United States Patent Application Serial No. 10/751,216, entitled "On-line Merchandise Return Labels" filed on January 2, 2004, which is a Continuation of this Application.
      A copy of the Appeal Brief filed on April 15, 2009, as relating United States Patent Application Serial No. 10/751,216, is included in Appendix C, attached hereto.

2.   United States Patent Application Serial No. 10/750,935, entitled "On-Line Rules-Based Return Processing" filed on January 2, 2004, which is also a Continuation of this Application.
      A copy of the Appeal Brief filed on April 15, 2009, as relating United States Patent Application Serial No. 10/750,935, is included in Appendix C, attached hereto.

To the knowledge of Appellant's counsel, there are no other known appeals, interferences, or judicial proceedings that will directly affect or be directly affected by or have a bearing on the Board's decision regarding this Appeal.

Status of Claims

Claims 1-46 are pending with Claims 10-34 withdrawn. Claims 1-9 and 35-46 are rejected pursuant to the Final Office Action dated November 19, 2008. Specifically, Claims 1-2, 4-6, 9, 35-41, and 44-46 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,980,862 issued to Arganbright et al. ("*Arganbright*") in view of U.S. Patent No. 6,246,997 issued to Cybul et al. ("Cybul"). Claims 3, 7-8, and 42-43 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Arganbright* in view of *Cybul* in further view of U.S. Patent Application Publication No. 2002/0010634 issued to Roman et al. ("*Roman*") and official notice.

For the reasons discussed below, Appellant respectfully submits that the rejection of Claims 1-9 and 35-46 are improper and should be reversed by the Board. Accordingly, Appellant presents Claims 1-9 and 35-46 for Appeal. All pending claims are shown in Appendix A, attached hereto

Status of Amendments

All amendments submitted by Appellant have been entered by the Examiner.

Summary of Claimed Subject Matter

FIGURES 1A-1B illustrate web pages incorporating teachings of the present invention. Specifically, FIGURE 1A illustrates a web access tool displaying a web page containing transaction history 101 which includes individual transactions indicative of merchandise purchased by a user logged on to a client system. This example web page was preferably sent from a server system to the client system when the user logged on to the client system and requested to process a merchandise return. This example web page contains transaction listing 101, returns summary section 102, single-action returns section 103, detailed item description section 104, user identification section 107, and returns information section 108. One skilled in the art can appreciate that these various sections may be omitted, rearranged or adapted in various ways without departing from the spirit and scope of the present invention. In general, the user is preferably made aware of the item or items to be returned by the single action and of the single action needed to begin the returns process. (Page 9, lines 7-26.)

Transaction listing 101 and detailed item description section 104 preferably provide information that identifies and describes the item(s) selected by the user and which may be returned. The server system adds transaction listing 101 and detailed item description 104 to each web page for the item(s) the user has purchased from various retailers. The server system, however, preferably adds single-action returns section 103 when single-action ordering is enabled for the user logged onto the client system. One skilled in the art would appreciate that a single web page on the server system may contain all these sections but single-action returns section 103 may be selectively included or excluded before sending the web page to the client system. (Page 9, line 27 - page 11, line 9.)

Single-action returns section 103 allows the user to specify, with a single action such as a single click of a mouse button, to return items of merchandise selected from individual transactions contained in transactions listing 101. Once the user has performed the preferred single action, the returns process for the selected item(s) is initiated. Single-action returns section 103 preferably contains single-action return button 103a, user identification subsection 103b, and single-action return information subsections 103c and 103d. (Page 10, lines 10-19.)

When the user selects single-action returns button 103a, the client system sends a return request to the server system indicating the user's desire that the merchandise items associated with transactions selected in transaction listing 101 be returned. After the server system

receives the return request, the server system provides the client system with a new web page confirming the receipt of the return request. The processing of the client system and the server system will be discussed in greater detail below. (Page 11, lines 17-26.)

FIGURE 2 is a block diagram illustrating a system incorporating teachings of the present invention. System 200 preferably supports single-action returns over the Internet using the World Wide Web. Server system 210 includes server engine 211, client identifier/customer table 212, various web page templates 213, customer database 214, transaction database 215, and retailer database 216. Server engine 211 preferably receives HTTP (Hypertext Transfer Protocol) requests to access web pages identified by URLs (Universal Resource Locator) and provides the web pages to the various client systems 220. Such an HTTP request may indicate that the user has performed the single action necessary to effect single-action returns. (Page 13, lines 6-19.)

Customer database 214 preferably contains customer information for various users or potential users. Customer information may include user-specific return information such as the name of the customer, credit information, and shipping information in a user preference profile. Transaction database 215 preferably contains entries indicative of transactions associated with registered users, preferably transactions which were performed at single-action returns participating retailers. Retailer database 216 contains a listing of the various retailers that participate in a local returns of remotely purchased merchandise program. Client identifier/customer table 212 contains a mapping from each client identifier, which is a globally unique identifier that uniquely identifies a client system, to the customer last associated with that client system. (Page 13, line 20 - page 14, line 4.)

FIGURE 5 is a flow diagram of a routine capable of processing single-action returns according to one embodiment of the present invention . . . Method 500 of FIGURE 5 begins at step 505. Once initialized, method 500 proceeds to step 510. At step 510, the user of client system 220 is identified. One method of identifying the user of client system 220 is the method of FIGURE 3. An alternative method of identifying the user of client system 220 is to obtain and review client identifier 222, if one is present, on client system 220. If the user of the client system is a new user, i.e., not yet registered or no client identifier 222 is provided, method 500 proceeds to step 515. (Page 17, lines 5-20.)

At step 515, it is determined whether or not the user is to be registered. This determination can be made by prompting the user, or by other means. If the new user does not

wish to be registered for single-action returns services or it is determined that the user is not to be registered, method 500 proceeds to step 520 where method 500 is ended. If the new user wishes to enable single-action returns, method 500 proceeds to step 525. (Page 17, lines 21-28.)

At step 525, a user preference profile for the new user is created and stored preferably on server system 210. Once the new user is registered and the user preference profile stored, a client identifier 222 is deposited on client system 220 and method 500 proceeds to step 535. (Page 17, line 29 - page 18, line 3.)

If at step 510, the user on client system 220 is identified as a registered user, i.e., a client identifier 222 exists on client system 220, method 500 proceeds to step 530. At step 530, the user preference profile of the registered user is retrieved and mapped using customer database 214 and client ID/customer table 212. Once the user preference profile has been retrieved, such as at step 530, or created, such as at step 525, method 500 proceeds to step 535. (Page 18, lines 4-12.)

At step 535, a transaction history for the user is preferably retrieved from transactions database 215. Transactions database 215 is preferably maintained by server system 210. However, transactions database 215 can be maintained at another location as well as created real-time from a collection of databases located at member retail sites, credit card sites or other data bases. Once an appropriate transaction history for the registered user has been retrieved at step 535, method 500 proceeds to step 540. (Page 18, lines 13-22.)

At step 540, the transaction history retrieved at step 535 is preferably displayed to the user for their perusal and subsequent selection of items of merchandise to be returned. The transaction history is preferably displayed in a manner similar to that illustrated in FIGURE 1A. In addition to the transaction history, single-action returns section 103 of the present invention is also preferably included on the displayed web page. Once transaction history 101 and other desired components of a single-action returns web page are displayed, method 500 proceeds to step 545. (Page 18, line 23 - page 20, line 2.)

At step 545, method 500 waits or loops until the user selects a transaction or item to be processed for returns. If a transaction or item is not selected within a predetermined amount of time, method 500 proceeds to step 550 where method 500 ends. Method 500 is designed to end after a predetermined amount of time for security reasons which can arise from client system 220 being left unattended or for other computer security threats. In response to the selection of

an item to be returned and the subsequent selection of single-action returns button 103a at step 545, method 500 proceeds to step 555. At step 555, the processing necessary for the return of the selected item or items of merchandise is initiated. (Page 19, lines 3-15.)

Referring now to FIGURE 6A, one embodiment of a flow diagram capable of completing the processing of a return request incorporating teachings of the present invention is shown. As illustrated in the embodiment of FIGURE 6A, in response to the initiation of returns processing at step 555, method 500a proceeds to step 558. (Page 19, lines 16-21.)

At step 558, the selected item or transaction is evaluated to determine whether or not the return is a valid return. One method of validating a return might involve comparing the item to be returned against a returns rule set for the retailer from which the item was purchased. Alternatively, if the transaction represented the purchase of a perishable item, a return might be determined to not be valid. If it is determined that the selected transaction or item is not a valid return, method 500a proceeds to step 561. (Page 19, lines 22-31.)

At step 561, the user is notified of the invalid return such as by a web page, email, or other capable means. Once the user has been notified that the return is invalid at step 561, method 500a ends at step 564. As an alternative to ending at any end step of methods 500, 500a or 500b, methods 500, 500a or 500b can return to a previous step, such as step 540 where the transaction listing is displayed to the user, or perform other actions within the spirit and scope of the present invention. (Page 20, lines 1-10.)

If at step 558, it is determined that the selected item or transaction for return is valid, method 500a proceeds to step 567. At step 567, the retailer from which the item was purchased is notified of the pending merchandise return. After the appropriate retailer is notified at step 567, the transaction information and the necessary user specific information such as that contained in the user preference profile, is provided to the retailer at step 570. (Page 20, lines 11-19.)

In addition to providing the retailer the necessary transaction information and the necessary user specific information at step 570, a shipping agent is notified of the need for a package pick up such that the item selected by the user may be returned at Step 573. To further simplify processing for both the shipping agent and the user, a return shipping label is preferably produced for the user to place on the package in which the merchandise for return will be shipped back to the retailer at step 576. It is also possible to have shipping paperwork generated and printed out at the facility of the shipping agent. At step 579, the package, once

picked up by the shipping agent, is forwarded to the appropriate destination, such as a retailer depot, auction site, etc. Method 500a completes returns processing at step 582. (Page 20, line 20 - page 21, line 4.)

Referring now to FIGURE 6B, an alternate embodiment of a flow diagram capable of completing the processing of a single-action return request incorporating teachings of the present invention is shown. Similar to FIGURE 6A, in response to the initiation of returns processing at step 555, method 500b proceeds to step 558. (Page 21, lines 5-10.)

At step 558, the selected item or transaction is evaluated to determine whether or not the return is a valid return. One method of validating a return might be to compare the item to be returned against a returns rule set for the retailer from which the item was purchased. Alternatively, if the transaction represented the purchase of a perishable item, a return might be determined to not be valid. If it is determined that the selected transaction or item is not a valid return, method 500b proceeds to step 561. (Page 21, lines 11-20.)

At step 561, the user is notified of the invalid return. Once the user has been notified that the return is invalid at step 561, method 500b ends at step 564. (Page 21, lines 21-23.)

If at step 558, it is determined that the selected item or transaction for return is valid, method 500b proceeds to step 573. At step 573, a shipping agent is notified of a package pick up for the return of the item selected by the user. To further simplify processing for both the shipping agent and the user, a return shipping label is preferably produced for the user to place on the package in which the return will be shipped at step 576. At step 579, the package, once picked up by the shipping agent, is forwarded to its appropriate destination. (Page 21, line 24 - page 23, line 2.)

Once the merchandise to be returned has been received at its destination or while the merchandise is in transit, the merchandise is disposed of at step 585. The present invention envisions a variety of different methods by which the returned merchandise may be disposed of. For example, the merchandise may be auctioned on an auctioning web-site, a live auction may be employed to dispose of the returned merchandise, or as illustrated in FIGURE 6A, the merchandise may be returned to the retailer from which it was purchased. (Page 22, lines 3-12.)

Once the merchandise has been disposed of at step 585, the proceeds of the disposal are credited to the user based upon settings available in the user preference profile at step 588. This method of disposal allows an auctioning agent to obtain the best price for the returned

merchandise and to collect a commission for their role in the disposition of the merchandise should they desire. For products which get returned to the retailer from which they were purchased, the user may be able to obtain a full refund for the unwanted merchandise from the retailer. Other methods of merchandise disposal are considered within the spirit and scope of the present invention. Once the user has been appropriately credited, method 500b completes at step 591. (Page 22, lines 13-26.)

To help minimize shipping costs and user confusion, the server system may combine various single-action returns into a multiple-item return. For example, if a user wishes to return more than one item to any given retailer or central depot, those returns may be cost effectively combined into a single return for shipping. As such, the server system preferably combines the single-action returns when their destination addresses are the same. (Page 22, line 27 - page 24, line 4.)

Although the present invention has been described in detail, it should be understood that various changes, substitutions and alterations can be made thereto without departing from the spirit and scope of the invention. (Page 25, lines 25-28.)

With regard to the independent claims currently under Appeal, Appellant provides the following concise explanation of the subject matter recited in the claim elements. For brevity, Appellant does not necessarily identify every portion of the Specification and drawings relevant to the recited claim elements. Additionally, this explanation should not be used to limit Appellant's claims but is intended to assist the Board in considering the Appeal of this Application.

For example, independent Claim 1 recites the following:

> A method for processing the returns of merchandise purchased through the World Wide Web (e.g., Figures 5 and 6A-6B, reference numerals 500-588; Page 17, line 5 through Page 23, line 4) comprising:
>
> receiving, from a consumer, an electronic request via a computerized system associated with the consumer, the electronic request requesting to initiate processing of one or more items of merchandise purchased by the consumer in a prior purchase transaction (e.g., Figure 1, reference numerals 101-110; Page 9, lines 7-16; Figure 5, reference numeral 510; Page 17, lines 10-20);
>
> in response to receiving the electronic request from the computing system associated with the consumer, gathering transaction history data associated with the consumer from a computerized database (e.g., Figure 5, reference numeral 535; Page 18, lines 13-22);

displaying the transaction history associated with the identified consumer to the consumer on the computerized system associated with the consumer, the transaction history identifying a listing of merchandise associated with the consumer (e.g., Figure 5, reference numeral 540; Page 18, line 23 through page 19, line 2);

in response to and after displaying the transaction history, receiving an electronic selection, generated by the consumer on the computerized system associated with the consumer, of a particular item of merchandise within the listing of merchandise in the displayed transaction history, the electronic selection comprising a click on the particular item of merchandise within the list of merchandise and identifying the particular item of merchandise for returns processing (e.g., Figure 5, reference numeral 545; Page 19, lines 3-15); and

in response to receiving the electronic selection comprising the click on the particular item of merchandise within the list of merchandise, initiating a returns process for the particular item of merchandise selected by the consumer from the list of merchandise purchased by the consumer in the prior purchase transaction, the returns process initiated by a returns server (e.g., Figure 2, reference numeral 210; Page 13, lines 6-19; Page 14 lines 5-21; Page 15, line 21 through Page 16, line 14; Figures 6A-6B, reference numerals 558-588; Page 20, line 16 through Page 23, line 26).

Dependent Claim 35 incorporates the steps of Claim 1 and further recites the following:

completing the returns process based upon settings in the consumer preference profile (e.g., Figures 6A-6B, reference numerals 585; Page 22, line 28 through Page 23, line 11).

Dependent Claim 39 incorporates the steps of Claim 1 and further recites the following:

receiving transaction history data from a retailer on a periodic basis (e.g., Figure 5, reference numeral 535; Page 18, line 22 through Page 19, line 2).

Dependent Claim 41 incorporates the steps of Claim 1 and further recites the following:

receiving a client system identifier in a message from the consumer (e.g., Figure 2, reference numeral 222; Page 14, lines 10-26).

Dependent Claim 44 incorporates the steps of Claim 1 and further recites the following:

determining if the selected item of merchandise is perishable (e.g., Figure 6A, reference numeral 558; Page 20, lines 3-12).

As another example, independent Claim 46 recites the following:

A method for processing the returns of merchandise purchased through the World Wide Web (e.g., Figures 5 and 6A-6B, reference numerals 500-588; Page 17, line 5 through Page 23, line 4) comprising:

receiving login information from a consumer associated with the purchase of one or more items of merchandise, the login information received from a computerized system associated with the consumer (e.g., Page 9, lines 8-16; Page 10, lines 3-6 and 21-24; Page 11, lines 8-12; Figure 5, reference numerals 505-530; Page 17, line 18 through Page 18, line 21);

using the login information to complete a login process to identify the consumer (e.g., Page 9, lines 8-16; Page 10, lines 3-6 and 21-24; Page 11, lines 8-12; Figure 5, reference numerals 505-530; Page 17, line 18 through Page 18, line 21);

gathering transaction history data associated with the identified consumer from a computerized database (e.g., Figure 5, reference numeral 535; Page 18, lines 13-22);

causing the transaction history associated with the identified consumer to be displayed to the consumer on the computerized system associated with the consumer, the transaction history identifying a listing of merchandise having been purchased by the consumer from a retailer (e.g., Figure 5, reference numeral 540; Page 18, line 23 through page 19, line 2);

in response to and after displaying the transaction history, receiving an electronic selection, generated by the consumer, of a particular item of merchandise within the listing of merchandise in the displayed transaction history, the electronic selection comprising a click on the particular item of merchandise within the list of merchandise and identifying the particular item of merchandise for returns processing (e.g., Figure 5, reference numeral 545; Page 19, lines 3-15); and

in response to receiving the electronic selection comprising the click on the particular item of merchandise within the list of merchandise, initiating a returns process for the particular item of merchandise selected by the consumer from the list of merchandise purchased by the consumer in a prior purchase transaction, the returns process initiated by a returns server (e.g., Figure 2, reference numeral 210; Page 13, lines 6-19; Page 14 lines 5-21; Page 15, line 21 through Page 16, line 14; Figures 6A-6B, reference numerals 558-588; Page 20, line 16 through Page 23, line 26).

Grounds of Rejection to be Reviewed on Appeal

Are Claims 1-2, 4-6, 9, 35-41, and 44-46 unpatentable under 35 U.S.C. § 103(a) over U.S. Patent No. 6,980,862 issued to Arganbright et al. ("*Arganbright*") in view of U.S. Patent No. 6,246,997 issued to Cybul et al. ("*Cybul*")?

Are Claims 3, 7-8, and 42-43 unpatentable under 35 U.S.C. § 103(a) over *Arganbright* in view of *Cybul* in further view of U.S. Patent Application Publication No. 2002/0010634 issued to Roman et al. ("*Roman*") and official notice?

Arguments

Claims 1-2, 4-6, 9, 35-41, and 44-46 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,980,862 issued to Arganbright et al. ("*Arganbright*") in view of U.S. Patent No. 6,246,997 issued to Cybul et al. ("*Cybul*"). Claims 3, 7-8, and 42-43 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Arganbright* in view of *Cybul* in further view of U.S. Patent Application Publication No. 2002/0010634 issued to Roman et al. ("*Roman*") and official notice. For at least the following reasons, Appellant respectfully submits that these rejections are improper and should be reversed by the Board. Appellant addresses independent Claims 1 and 46 and dependent Claims 35, 39, 41, and 44 below.

I.   Legal Standard for Obviousness

The question raised under 35 U.S.C. § 103 is whether the prior art taken as a whole would suggest the claimed invention taken as a whole to one of ordinary skill in the art at the time of the invention. One of the three basic criteria that must be established by an Examiner to establish a *prima facie* case of obviousness is that "the prior art reference (or references when combined) must teach or suggest **all the claim limitations**." *See* M.P.E.P. § 706.02(j) citing *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991) (emphasis added). "*All words* in a claim must be considered in judging the patentability of that claim against the prior art." *See* M.P.E.P. § 2143.03 citing *In re Wilson*, 424 F.2d 1382, 1385 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970) (emphasis added).

In addition, even if all elements of a claim are disclosed in various prior art references, which is certainly not the case here as discussed below, the claimed invention taken as a whole still cannot be said to be obvious without some reason why one of ordinary skill at the time of the invention would have been prompted to modify the teachings of a reference or combine the teachings of multiple references to arrive at the claimed invention.

The controlling case law, rules, and guidelines repeatedly warn against using an Appellant's disclosure as a blueprint to reconstruct the claimed invention. For example, the M.P.E.P. states, "The tendency to resort to 'hindsight' based upon Appellant's disclosure is often difficult to avoid due to the very nature of the examination process. However,

impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art." M.P.E.P. § 2142.

The U.S. Supreme Court's decision in *KSR Int'l Co. v. Teleflex, Inc.* reiterated the requirement that Examiners provide an explanation as to why the claimed invention would have been obvious. *KSR Int'l Co. v. Teleflex, Inc.*, 127 S.Ct. 1727 (2007). The analysis regarding an apparent reason to combine the known elements in the fashion claimed in the patent at issue "should be made explicit." *KSR*, 127 S.Ct. at 1740-41. "Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *Id.* at 1741 (internal quotations omitted).

The new examination guidelines issued by the PTO in response to the *KSR* decision further emphasize the importance of an explicit, articulated reason why the claimed invention is obvious. Those guidelines state, in part, that "[t]he key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR* noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit." *Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in View of the Supreme Court Decision in KSR International Co. v. Teleflex Inc.*, 72 Fed. Reg. 57526, 57528-29 (Oct. 10, 2007) (internal citations omitted). The guidelines further describe a number of rationales that, in the PTO's view, can support a finding of obviousness. *Id.* at 57529-34. The guidelines set forth a number of particular findings of fact that must be made and explained by the Examiner to support a finding of obviousness based on one of those rationales. *See id.*

II.   Claims 1-2, 4-6, 9, 36-38, 40, and 45-46 are Allowable over the *Arganbright-Cybul* Combination

The *Final Office Action* is deficient at least because the cited references, taken alone or in combination, do not disclose, teach, or suggest all the elements of Appellant's Claims 1-2, 4-6, 9, 36-38, 40, and 44-46. For example, independent Claim 1 of the present Application, as amended, recites:

A method of using the Internet to provide return labels to customers for facilitating returns of merchandise, comprising the steps of:

receiving, from a consumer, an electronic request via a computerized system associated with the consumer, the electronic request requesting to initiate processing of one or more items of merchandise purchased by the consumer in a prior purchase transaction;

in response to receiving the electronic request from the computing system associated with the consumer, gathering transaction history data associated with the consumer from a computerized database;

displaying the transaction history associated with the identified consumer to the consumer on the computerized system associated with the consumer, the transaction history identifying a listing of merchandise associated with the consumer;

in response to and after displaying the transaction history, receiving an electronic selection, generated by the consumer on the computerized system associated with the consumer, of a particular item of merchandise within the listing of merchandise in the displayed transaction history, the electronic selection comprising a click on the particular item of merchandise within the list of merchandise and identifying the particular item of merchandise for returns processing; and

in response to receiving the electronic selection comprising the click on the particular item of merchandise within the list of merchandise, initiating a returns process for the particular item of merchandise selected by the consumer from the list of merchandise purchased by the consumer in the prior purchase transaction, the returns process initiated by a returns server.

Because the proposed *Arganbright-Cybul* combination does not disclose, teach, or suggest at least the claim elements emphasized above, Appellant submits that the rejection of Claim 1 is improper and should be withdrawn. Because independent Claim 46 recites certain similar claim elements, Appellant submits that the rejections of Claim 46 is improper for analogous reasons and should also be withdrawn.

A.   **The proposed combination does not disclose, teach, or suggest "*in response to and after displaying the transaction history, receiving an electronic selection, generated by the consumer on the computerized system associated with the consumer, of a particular item of merchandise within the listing of merchandise in the displayed transaction history, the electronic selection comprising a click on the particular item of merchandise within the list of merchandise and identifying the particular item of merchandise for returns processing.*"**

As a first example of the deficiencies of the *Arganbright-Cybul* combination, Appellant respectfully submits that the cited references do not disclose, teach, or suggest "in response to and after displaying the transaction history, receiving an electronic selection, generated by the

consumer on the computerized system associated with the consumer, of a particular item of merchandise within the listing of merchandise in the displayed transaction history, the electronic selection comprising a click on the particular item of merchandise within the list of merchandise and identifying the particular item of merchandise for returns processing," as recited in Claim 1. In the *Final Office Action*, the Examiner acknowledges that *Arganbright* does not disclose the recited claim elements and instead relies upon *Cybul*. (*Final Office Action*, page 3). Appellant respectfully disagrees.

The cited portion of *Cybul* merely discloses "a list builder tool" that "efficiently find[s] and select[s] the past shopping history of respective shoppers and import[s] that data to the list builder's on-line historical purchase list database, thereby making it available for the shoppers' first and subsequent on-line shopping experiences." (*Cybul*, Column 4, lines 25-35). Thus, the selection referred to by *Cybul* is performed by a server-based "list builder tool." The application finds and selects items previously purchased by the customer. The selection, however, is not by a customer, via a web access tool. The selection is not a click on the particular item of merchandise, and the selection does not identify a particular item of merchandise for returns processing. Accordingly, it is Appellant's position that neither *Arganbright* nor *Cybul* (or their proposed combination) disclose, teach, or suggest "in response to and after displaying the transaction history, receiving **an electronic selection, generated by the consumer** on the computerized system associated with the consumer, of **a particular item of merchandise** within the listing of merchandise in the displayed transaction history, the electronic selection comprising a click on the particular item of merchandise within the list of merchandise and **identifying the particular item of merchandise for returns processing**," as recited in Claim 1. The recited claim elements are absent from the disclosures of *Arganbright* and *Cybul*.

Additionally, Appellant submits that it would not have been obvious to one of ordinary skill in the art at the time the invention was made to modify *Arganbright* in view of *Cybul* to include an electronic selection from a displayed list of items to the consumer to identify an item for returns processing. *Arganbright* discloses that the process for handling returns begins when "the system presents the user with a copy of the satisfaction guarantee 2702." (*Arganbright*, Column 63, lines 3-5). Thus, the process initiates with the presentation of the return policy to the user. "After the user has a chance to review satisfaction guarantee 2702, the user selects whether the user wishes to "return" or "exchange" (box 2704) an item or

plurality of items." (*Arganbright*, Column 63, lines 8-11). Thus, the first electronic request received from the user relating to the return of a product is the selection of either a "return" button or an "exchange" button. "If the user selects "return," an online return form 2706 is presented to the user." (*Arganbright*, Column 63, lines 12-13). "The user is then requested to enter a plurality of information (box 2708) on return form 2706, including but not limited to, quantity, stock number or SKU, the reason for the return, product description, and an invoice number." (*Arganbright*, Column 63, lines 13-17, emphasis added). Once the return form is populated by the customer's input, the return form is "presented to the user in a format (box 2710) that can be printed on a conventional printer connected to the user's computer" and that the user "is requested to print the form and include the form in the box containing the product or products to be returned." (*Arganbright*, Column 63, lines 23-29). Thus, the form must be filled out by the customer and the transaction information is provided in the box of merchandise returned by the customer. Nothing is presented to the user that would be appropriate for selection by a click on a particular item of merchandise to identify that item for returns processing.

Even when considered in conjunction with the disclosure of *Cybul*, Appellant's claim language would not have been obvious to one of ordinary skill in the art. As discussed above, *Cybul* relates to a system for online shopping that "takes advantage of the data already being gathered by POS systems on consumer shopping habits and preferences." (*Cybul*, Column 1, lines 36-38). Specifically, *Cybul* discloses that where a vendor's POS system "supports a frequent shopper or loyalty program . . . [or]a database of historical purchase data indexed by loyalty customer," the information may be extracted from the vendor's POS system. (*Cybul*, Column 4, lines 25-34; Column 1, lines 63-65). As a result, a list builder tool can "efficiently find and select the past shopping history of respective shoppers and import that data to the list builder's on-line historical purchase list database, thereby making it available for the shoppers' first and subsequent on-line shopping experiences." (*Cybul*, Column 4, lines 29-34). As such, *Cybul* merely discloses that a shopper's purchases in a brick-and-mortar store are used to develop an online shopping list for that shopper's subsequent purchases on-line.

Accordingly, at most the *Arganbright-Cybul* combination discloses that during an online purchase, a customer's in store purchases may be used to efficiently develop an on-line shopping list. If an item were needed to be returned after the purchase is complete, the proposed combination merely discloses that a return form could be obtained on-line and filled

out by the customer on the customer's computer, as disclosed in *Arganbright*. The form would then be printed and placed in the box for shipping. It would not have been obvious to one of ordinary skill in the art to modify the return process of *Arganbright* and the purchase process of *Cybul* to result in Appellant's recited step of "in response to and after displaying the transaction history, **receiving an electronic selection, generated by the consumer** on the computerized system associated with the consumer, of **a particular item of merchandise** within the listing of merchandise in the displayed transaction history, the electronic selection comprising a click on the particular item of merchandise within the list of merchandise and **identifying the particular item of merchandise for returns processing**," as recited in Claim 1.

For at least these additional reasons, Appellant respectfully requests reconsideration and allowance of independent Claim 1, together with Claims 2, 4-6, 9, 36-38, 40, and 45 that depend on Claim 1. For analogous reasons, Appellant also requests reconsideration and allowance of independent Claim 46.

B. **The proposed combination does not disclose, teach, or suggest "*in response to receiving the electronic selection comprising the click on the particular item of merchandise within the list of merchandise, initiating a returns process for the particular item of merchandise selected by the consumer from the list of merchandise purchased by the consumer in the prior purchase transaction, the returns process initiated by a returns server.*"**

As a second example of the deficiencies of the *Arganbright-Cybul* combination, Appellant respectfully submits that the cited references do not disclose, teach, or suggest "in response to receiving the electronic selection comprising the click on the particular item of merchandise within the list of merchandise, initiating a returns process for the particular item of merchandise selected by the consumer from the list of merchandise purchased by the consumer in the prior purchase transaction, the returns process initiated by a returns server," as recited in Claim 1. In the *Final Office Action*, the Examiner relies upon *Arganbright* for the operation of initiating a returns process by a returns server in response to a selection of an item. (*Final Office Action*, page 2). Initially, Appellant respectfully notes that Appellant's claim does not merely recite receiving from the consumer an electronic request to initiate return processing. Appellant's claim recites "initiating a returns process for the particular item of merchandise . . . by a returns server," and this operation is not disclosed in *Arganbright*.

Arganbright merely discloses that "[a]fter the user has a chance to review satisfaction guarantee 2702, the user selects whether the user wishes to "return" or "exchange" (box 2704) an item or plurality of items." (Column 63, lines 8-11). Thus, this portion refers to the selection of either a "return" button or an "exchange" button by a user. Appellants point out that the selection of the "return" button occurs before the user populates the form and before the user identifies a product by sku # for return. (Column 63, lines 12-22). As a result, the selection of the "return" button occurs before an item of merchandise is identified for return. The mere presentation of form before the identification of the product to be returned is not analogous to "initiating a returns process for the particular item of merchandise selected by the consumer from the list of merchandise purchased by the consumer in the prior purchase transaction, the returns process initiated by a returns server," as recited by Appellant's amended Claim 1. Further, because there is no disclosure in *Arganbright* of any returns processing being initiated after the form is populated, the system of *Arganbright* cannot be said to perform any returns processing.

Appellant additionally notes that in the *Final Office Action* the Examiner relies upon *Cybul* for disclosure of the electronic selection of the particular item of merchandise and upon *Arganbright* for the operation of initiating a returns process by a returns server. (*Final Office Action*, pages 3-5). However, Appellant's claim recites a specific order to and interrelation between the steps of the claimed method. Specifically, Claim 1 recites "in response to receiving the electronic selection comprising the click on the particular item of merchandise within the list of merchandise, initiating a returns process for the particular item of merchandise selected by the consumer from the list of merchandise purchased by the consumer in the prior purchase transaction, the returns process initiated by a returns server." Thus, a click on a particular item of merchandise previously purchased by a customer is first received from a customer. Then, in response to that click, a returns process for the selected item of merchandise is initiated by a returns server.

To the extent that *Arganbright* discloses initiating a returns process by a returns server (which Appellant expressly disputes above), such returns process is not "in response to receiving the electronic selection comprising the click on the particular item of merchandise within the list of merchandise" from the customer. Appellant also notes that *Cybul* does not at all relate to a returns process or to the processing of returns of merchandise. Even more troubling, as shown above in Section A(1) of this Response, *Cybul* does not even disclose the

recited "electronic selection comprising the click on the particular item of merchandise" from the customer. The M.P.E.P. provides that "[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art." M.P.E.P. § 2143.03 (citing *In re Wilson*, 424 F.2d 1382, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970)). Because of the deficiencies of these references and the deficiencies of their proposed combination, Appellants respectfully submit that the piecemeal rejection of Appellant's claim over the proposed *Arganbright-Cybul* combination fails to give credence to the particular combination of claim elements and the sequence of claim steps specifically recited in Appellant's claim.

For at least these additional reasons, Appellant respectfully requests reconsideration and allowance of independent Claim 1, together with Claims 2, 4-6, 9, 36-38, 40, and 45 that depend on Claim 1. For analogous reasons, Appellant also requests reconsideration and allowance of independent Claim 46.

C.   **The proposed combination does not disclose, teach, or suggest** *"in response to receiving the electronic request from the computing system associated with the consumer, gathering transaction history data associated with the consumer from a computerized database."*

As a third example of the deficiencies of the *Arganbright-Cybul* combination, Appellant's Claim 1 recites "in response to receiving the return request from the customer, gathering transaction history data associated with the customer from a computerized database." Thus, Appellant's claim recites a specific order to the steps of the claimed method. First, a return request is received via the Internet. Then, in response to that return request, transaction history data associated with the customer is gathered from a computerized database. Appellant respectfully submits that the proposed *Arganbright-Cybul* combination does not disclose, teach, or suggest the features and operations recited in Appellant's claim.

In the *Office Action*, the Examiner acknowledges that *Arganbright* does not disclose the recited claim elements and instead relies upon *Cybul*, specifically, for disclosure of the recited claim elements. (*Office Action*, page 3). Appellant respectfully disagrees. *Cybul* relates to a system for online shopping that "takes advantage of the data already being gathered by POS systems on consumer shopping habits and preferences." (*Cybul*, Column 1, lines 36-38). Specifically, *Cybul* discloses that where a vendor's POS system "supports a frequent shopper or loyalty program . . . [or] a database of historical purchase data indexed by loyalty customer," the information may be extracted from the vendor's POS system. (*Cybul*, Column 4, lines 25-34;

Column 1, lines 63-65; Abstract). As a result, a list builder tool can "efficiently find and select the past shopping history of respective shoppers and import that data to the list builder's on-line historical purchase list database, thereby making it available for the shoppers' first and subsequent on-line shopping experiences." (*Cybul*, Column 4, lines 29-34; Abstract). As such, *Cybul* merely discloses that a shopper's purchases in a brick-and-mortar store are used to develop an online shopping list for that shopper's subsequent purchases on-line. *Cybul* does not at all relate to a returns process and, thus, does not disclose, teach, or suggest gathering transaction history data associated with the customer from a computerized database "*in response to receiving the electronic request from the computing system associated with the consumer.*"

For at least these additional reasons, Appellant respectfully requests reconsideration and allowance of independent Claim 1, together with Claims 2, 4-6, 9, 36-38, 40, and 45 that depend on Claim 1. For analogous reasons, Appellant also requests reconsideration and allowance of independent Claim 46.

III.   Claim 35 is Allowable over the *Arganbright-Cybul* Combination

Dependent Claim 35 depends upon independent Claim 1, which Appellant has shown above to be allowable. Accordingly, dependent Claim 35 is not obvious over the proposed combination of references at least because Claim 35 includes the limitations of independent Claim 1. Additionally, the *Final Office Action* is further deficient because the cited references, taken alone or in combination, do not disclose, teach, or suggest all the elements of Appellant's dependent Claim 35.

For example, the proposed *Arganbright-Cybul* combination does not disclose, teach, or suggest "completing the returns process based upon settings in the consumer preference profile," as recited in Claim 35. In the *Final Office Action*, the Examiner relies specifically upon *Arganbright* for disclosure of the recited claim elements. (*Final Office Action*, page 6). However, *Arganbright* merely discloses a program that "tracks a Member's shopping history." (*Arganbright*, Column 65, lines 7-10). According to *Arganbright*, once a shopper completes the payment information and submits the order during an initial purchase, an email notification is sent to the consumer, and the email may include details such as "order status, order number, line item details, sub totals, tax shipping, service charges, and a grand total" as

well as "shipping/billing information" and "a link that allows the user to view order details." (*Arganbright*, Column 62, lines 31-44). The disclosed email notification is not at all related to a returns process and certainly does not include "retrieving a preference profile for the identified customer" and "completing the returns process based upon settings in the consumer preference profile," as required by Claim 35.

In the case of a return, it is handled "via an online form." (*Arganbright*, Column 62, lines 57-59). According to *Arganbright*, the process initiates with the presentation of the return policy to the user. "After the user has a chance to review satisfaction guarantee 2702, the user selects whether the user wishes to "return" or "exchange" (box 2704) an item or plurality of items." (*Arganbright*, Column 63, lines 8-11). Thus, the first electronic request received from the user relating to the return of a product is the selection of either a "return" button or an "exchange" button. "If the user selects "return," an online return form 2706 is presented to the user." (*Arganbright*, Column 63, lines 12-13). "The user is then requested to enter a plurality of information (box 2708) on return form 2706, including but not limited to, quantity, stock number or SKU, the reason for the return, product description, and an invoice number." (*Arganbright*, Column 63, lines 13-17, emphasis added). Once the return form is populated by the customer's input, the return form is "presented to the user in a format (box 2710) that can be printed on a conventional printer connected to the user's computer" and that the user "is requested to print the form and include the form in the box containing the product or products to be returned." (*Arganbright*, Column 63, lines 23-29). Thus, the form must be filled out by the customer and the transaction information is provided in the box of merchandise returned by the customer. There is no disclosure in *Arganbright* or the *Arganbright-Cybul* combination of "retrieving a preference profile for the identified customer" and "completing the returns process based upon settings in the consumer preference profile," as required by Claim 35.

For at least these reasons, Appellant respectfully requests reconsideration and allowance Claim 35.

IV.   Claim 39 is Allowable over the *Arganbright-Cybul* Combination

Dependent Claim 39 depends upon independent Claim 1, which Appellant has shown above to be allowable. Accordingly, dependent Claim 39 is not obvious over the proposed combination of references at least because Claim 39 includes the limitations of independent Claim 1. Additionally, the *Final Office Action* is further deficient because the cited references, taken alone or in combination, do not disclose, teach, or suggest all the elements of Appellant's dependent Claim 39.

For example, the proposed *Arganbright-Cybul* combination does not disclose, teach, or suggest "receiving transaction history data from a retailer on a periodic basis," as recited in Claim 39. In the *Final Office Action*, the Examiner relies specifically upon *Arganbright* for disclosure of the recited claim elements. (*Final Office Action*, page 5). However, the cited portion of *Arganbright* merely discloses a client/server system in which a customer can purchase items from a product list 90. (*Arganbright*, Column 48, lines 1-65). According to *Arganbright*, "in order to select a product for purchase, a user fills in a quantity 92 on product list 90." (*Arganbright*, Column 48, lines 33-34). "Upon selecting the quantities for purchase for a plurality of products, the user can then initiate the Add to Basket link 94, by double clicking a mouse, for example, to add the selected products to a shopping basket." (*Arganbright*, Column 48, lines 35-38). Thus, the cited portion of *Arganbright* merely relates to the purchasing of an item by a consumer by adding items from a product list to a virtual shopping basket. There is no disclosure in the cited portion or in any other portion of *Arganbright* of "receiving transaction history data **from a retailer on a periodic basis**," as recited in Claim 39.

For at least these reasons, Appellant respectfully requests reconsideration and allowance Claim 39.

V.   Claim 41 is Allowable over the Proposed *Arganbright-Cybul* Combination

Claim 41 depends upon independent Claim 1, which Appellant has shown above to be allowable. Accordingly, dependent Claim 41 are not obvious over the various combinations of references relied upon by the Examiner at least because Claim 41 include the limitations of

Claim 1. Additionally, dependent Claim 41 recite further elements that distinguish Appellant's claims over the prior art of record.

For example, Claim 41 recites "identifying the consumer, wherein identifying the consumer comprises receiving a client system identifier in a message from the consumer." In the *Final Office Action*, the Examiner relies upon *Arganbright* for disclosure of the recited claim elements. (*Final Office Action*, page 41). However, the cited portion of *Arganbright* merely discloses that "WWW shoppers are also preferably able to search and add to their shopping cart specific product SKUs, or identification numbers." (*Arganbright*, Column 48, lines 5-14). Using conventional online shopping techniques, users can add selected products to a shopping basket. (*Arganbright*, Column 48, lines 33-38). During checkout, the user is authenticated upon being "forwarded to a login/create new user page (not shown)." (*Arganbright*, Column 48, lines 52-62). Thus, the cited portion of *Arganbright* merely discloses allowing a user to purchase items placed in an online shopping basket after a user logs in. There is no disclosure of "a **client system** identifier." To the contrary, login information is associated with the user not the client system that the user uses. Accordingly, the proposed *Arganbright-Cybul* combination does not disclose, teach, or suggest "identifying the consumer, wherein identifying the consumer comprises receiving a client system identifier in a message from the consumer," as recited in Claim 41.

VI.   Claim 44 is Allowable over the *Arganbright-Cybul* Combination

Dependent Claim 44 depends upon independent Claim 1, which Appellant has shown above to be allowable. Accordingly, dependent Claim 44 is not obvious over the proposed combination of references at least because Claim 44 includes the limitations of independent Claim 1. Additionally, the *Final Office Action* is further deficient because the cited references, taken alone or in combination, do not disclose, teach, or suggest all the elements of Appellant's dependent Claim 44.

For example, the proposed *Arganbright-Cybul* combination does not disclose, teach, or suggest that initiating the return process comprises "determining if the selected item of merchandise is perishable," as recited in Claim 44. In the *Final Office Action*, the Examiner relies specifically upon *Arganbright* for disclosure of the recited claim elements. (*Final Office Action*, page 5). However, *Arganbright* merely discloses a process for handling returns that

begins when "the system presents the user with a copy of the satisfaction guarantee 2702." (*Arganbright*, Column 63, lines 3-5). Thus, the process initiates with the presentation of the return policy to the user. "After the user has a chance to review satisfaction guarantee 2702, the user selects whether the user wishes to "return" or "exchange" (box 2704) an item or plurality of items." (*Arganbright*, Column 63, lines 8-11). Thus, the first electronic request received from the user relating to the return of a product is the selection of either a "return" button or an "exchange" button. "If the user selects "return," an online return form 2706 is presented to the user." (*Arganbright*, Column 63, lines 12-13). "The user is then requested <u>to enter a plurality of information</u> (box 2708) on return form 2706, including but not limited to, quantity, stock number or SKU, the reason for the return, product description, and an invoice number." (*Arganbright*, Column 63, lines 13-17, emphasis added). Once the return form is populated by the customer's input, the return form is "presented to the user in a format (box 2710) that can be printed on a conventional printer connected to the user's computer" and that the user "is requested to print the form and include the form in the box containing the product or products to be returned." (*Arganbright*, Column 63, lines 23-29). Thus, *Arganbright* merely discloses a form that must be filled out by the customer and placed in the box with the merchandise returned by the customer. At most, *Arganbright* discloses the customer identifying the reason for the return. However, there is no disclosure in the cited portion or in any other portion of *Arganbright* that initiating the return process comprises "determining if the selected item of merchandise is perishable," as recited in Claim 44.

For at least these reasons, Appellant respectfully requests reconsideration and allowance Claim 44.

VII. The *Arganbright-Cybul* and *Arganbright-Cybul-Roman-Official Notice* Combinations are Improper as Applied to Appellant's Claims

Furthermore, Appellant submits that the Examiner has not presented a legally sufficient argument demonstrating a motivation to combine *Arganbright* with *Cybul* and/or *Roman*.

According to the M.P.E.P., in order "[t]o establish a prima facie case of obviousness . . . there must be some suggestion or motivation either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to

combine reference teachings." See §2143. Notably absent from this list is an allowance for an Examiner's conjectured assertion as to the motivation to combine reference teachings. A quote from the M.P.E.P. is directed specifically to this point: "[t]he examiner and the board asserted that it would have been within the skill of the art to substitute one type of detector for another in the system of the primary reference, however the court found there was **no support or explanation** of this conclusion and reversed." See §2143.01 (I) (emphasis added). Thus, "the proper inquiry is whether there is something in the prior art as a whole to suggest the *desirability* . . . of making the combination." *Id.* (internal quotations omitted) (emphasis original). "The mere fact that the references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the **desirability** of the combination." See §2143.01 (III) (emphasis original and added). Most recently, this requirement has been reaffirmed in an official USPTO memorandum dated May 3, 2007 wherein the Deputy Commissioner for Patent Operations pointed to sections of *KSR v. Teleflex*, which recite, "it will be necessary . . . to determine whether there was an **apparent reason** to combine the known elements in the fashion claimed by the patent at issue." *KSR Int'l. Co v. Teleflex Inc.*, No. 04-1350 (April 30, 2007) (emphasis added).

As applied to the present application, the *Final Office Action* has failed to meet this burden because the Examiner has not shown "something in the prior art as a whole to suggest the *desirability*" of combining *Arganbright* with *Cybul* and/or *Roman*, but rather seems to rely on a conjectured assertion that "the references can be combined" without regard to the "desirability of the combination." This directly conflicts with the M.P.E.P. requirements for supporting a motivation to combine references. Specifically, the Examiner only states "it would have been obvious . . . to incorporate the teachings of *Cybul* into the disclosure of *Arganbright* in order to provide the consumer with the option to return items via internet or online." (*Final Office Action*, page 4). Additionally, the Examiner states that "it would have been obvious . . . to incorporate the teachings of *Roman* into the disclosure of *Arganbright* in view of *Cybul* in order to minimize the loss of revenues of the merchant." (*Final Office Action*, page 6). These bald assertions do not meet the requirements of the M.P.E.P. The Examiner did not provide "support or explanation" for the motivation to make the proposed combinations nor did the Examiner show any "desirability" of doing so. Instead, the Examiner seems to base this assertion on pure conjecture. The alleged advantages provided by the Examiner do not provide an explanation as to: (1) why it would have been obvious to

one of ordinary skill in the art at the time of Appellant's invention *without using Appellants'*
claims as a guide to modify the particular techniques disclosed in *Arganbright* with the cited
disclosure in *Roman*; (2) how one of ordinary skill in the art at the time of Applicants'
invention would have actually done so; and (3) how doing so would purportedly meet the
limitations of Claim 1. Indeed, if it were sufficient for Examiners to merely point to a
purported advantage of one reference and conclude that it would have been obvious to
combine of modify that reference with other references simply based on that advantage
(which, as should be evident from the case law discussed above, it certainly is not), then
virtually any two or more references would be combinable just based on the fact the one
reference states an advantage of its system. Of course, as the Federal Circuit has made clear
and as discussed above, that is not the law.

For at least these reasons, Appellant requests that the rejections of the present claims
be withdrawn for want of a *prima facie* showing of obviousness as defined by the M.P.E.P.
and for the various other reasons described above.

CONCLUSION

Appellant has demonstrated that the present invention, as claimed, is clearly distinguishable over the prior art cited by the Examiner. Therefore, Appellant respectfully requests the Board to reverse the final rejections and instruct the Examiner to issue a Notice of Allowance with respect to all pending claims.

The Commissioner is hereby authorized to charge $270.00 for filing this Brief in support of an Appeal to Deposit Account No. 02-0384 of Baker Botts, L.L.P. No other fees are believed due; however, the Commissioner is authorized to charge any additional fees or credits to Deposit Account No. 02-0384 of Baker Botts, L.L.P.

Respectfully submitted,

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Dated: April 15, 2009

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APPENDIX A

Pending Claims

1.   (Previously Presented) A method for processing the returns of merchandise purchased through the World Wide Web comprising:

receiving, from a consumer, an electronic request via a computerized system associated with the consumer, the electronic request requesting to initiate processing of one or more items of merchandise purchased by the consumer in a prior purchase transaction;

in response to receiving the electronic request from the computing system associated with the consumer, gathering transaction history data associated with the consumer from a computerized database;

displaying the transaction history associated with the identified consumer to the consumer on the computerized system associated with the consumer, the transaction history identifying a listing of merchandise associated with the consumer;

in response to and after displaying the transaction history, receiving an electronic selection, generated by the consumer on the computerized system associated with the consumer, of a particular item of merchandise within the listing of merchandise in the displayed transaction history, the electronic selection comprising a click on the particular item of merchandise within the list of merchandise and identifying the particular item of merchandise for returns processing; and

in response to receiving the electronic selection comprising the click on the particular item of merchandise within the list of merchandise, initiating a returns process for the particular item of merchandise selected by the consumer from the list of merchandise purchased by the consumer in the prior purchase transaction, the returns process initiated by a returns server.

2.   (Previously Presented) The method of Claim 1 further comprising retrieving a preference profile for the identified consumer.

3.   (Previously Presented) The method of Claim 2 further comprising crediting a consumer account indicated in the consumer preference profile based upon the item selected.

4.   (Previously Presented) The method of Claim 1 further comprising notifying a retailer associated with the item selected by the consumer.

5.   (Previously Presented) The method of Claim 4 further comprising providing the retailer with the transaction information and consumer information associated with the item selected by the consumer.

6.   (Original) The method of Claim 1 further comprising generating a return shipping label for the merchandise to be returned.

7.   (Original) The method of Claim 1 further comprising notifying a shipping provider of a merchandise return to be picked up.

8.   (Previously Presented) The method of Claim 1 further comprising:
auctioning the merchandise selected for return by the consumer.

9.   (Original) The method of Claim 1 further comprising communicating between a client system and a server system via the Internet.

35.   (Previously Presented) The method of Claim 2, further comprising completing the returns process based upon settings in the consumer preference profile.

36.   (Previously Presented) The method of Claim 2, wherein the consumer preference profile comprises a name associated with the consumer, credit information associated with the consumer, and shipping information associated with the consumer.

37.   (Previously Presented) The method of Claim 1, wherein identifying the consumer comprises identifying the consumer using a login process.

38.   (Previously Presented) The method of Claim 37, further comprising requesting transaction history data from a retailer on a real-time basis upon identifying the consumer using the login process.

39.   (Previously Presented) The method of Claim 1, further comprising receiving transaction history data from a retailer on a periodic basis.

40.   (Previously Presented) The method of Claim 1, wherein the listing of merchandise in the transaction history is indicative of merchandise purchased by the consumer from an e-tailer.

41.   (Previously Presented) The method of Claim 1, further comprising identifying the consumer, wherein identifying the consumer comprises receiving a client system identifier in a message from the consumer.

42.   (Previously Presented) The method of Claim 1, wherein initiating the return process comprises validating the item of merchandise selected to authorize the return of the item of merchandise.

43.   (Previously Presented) The method of Claim 1, wherein initiating the return process comprises comparing information associated with the selection of the item of merchandise to at least one return rule of a retailer associated with the transaction.

44.   (Previously Presented) The method of Claim 1, wherein initiating the return process comprises determining if the selected item of merchandise is perishable.

45.   (Previously Presented) The method of Claim 1, wherein initiating the return process comprises using the computerized system associated with the consumer to generate a return shipping label to be used to return the selected item.

46.   (Previously Presented) A method for processing the returns of merchandise purchased through the World Wide Web comprising:

receiving login information from a consumer associated with the purchase of one or more items of merchandise, the login information received from a computerized system associated with the consumer;

using the login information to complete a login process to identify the consumer;

gathering transaction history data associated with the identified consumer from a computerized database;

causing the transaction history associated with the identified consumer to be displayed to the consumer on the computerized system associated with the consumer, the transaction history identifying a listing of merchandise having been purchased by the consumer from a retailer;

in response to and after displaying the transaction history, receiving an electronic selection, generated by the consumer, of a particular item of merchandise within the listing of merchandise in the displayed transaction history, the electronic selection comprising a click on the particular item of merchandise within the list of merchandise and identifying the particular item of merchandise for returns processing; and

in response to receiving the electronic selection comprising the click on the particular item of merchandise within the list of merchandise, initiating a returns process for the particular item of merchandise selected by the consumer from the list of merchandise purchased by the consumer in a prior purchase transaction, the returns process initiated by a returns server.

APPENDIX B

Evidence Appendix

Other than the references attached to this Appeal Brief as Appendices A and B, no evidence was submitted pursuant to 37 C.F.R. §§ 1.130, 1.131, or 1.132, and no other evidence was entered by the Examiner and relied upon by Appellant in the Appeal.

APPENDIX C

Related Proceedings Appendix

As stated on Page 3 of this Appeal Brief, United States Patent Application Serial No. 10/751,216 and United States Patent Application Serial No. 10/750,935 are under appeal and may be related to or affect the bearing on the Board's decision in this Appeal. Accordingly, copies of the Appeal Briefs for these pending Applications are attached.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
ON APPEAL FROM THE EXAMINER TO THE BOARD
OF PATENT APPEALS AND INTERFERENCES

In re Application of: Philip S. Siegel

U.S. Patent Serial No.:   10/751,216

Filing Date: January 2, 2004

Group No.:   3627

Examiner: Mussa A. Shaawat

Confirmation No.:   1168

Title: ON-LINE MERCHANDISE RETURN LABELS

MAIL STOP APPEAL BRIEF - PATENTS
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Dear Sir:

APPEAL BRIEF

Appellant has appealed to the Board of Patent Appeals and Interferences ("Board") from the Final Office Action dated November 19, 2008. Appellant is filing a Notice of Appeal concurrently with this Appeal Brief. This Appeal Brief is filed in response to Final Office Action dated November 19, 2008 and the Advisory Action dated February 19, 2009 finally rejecting Claims 1-5, 7, 8, 10-16, and 29-32 of Claims 1-5, 7-8, and 10-32 pending in this case.

Real Party In Interest

This Application is currently owned by Newgistics, Inc. as indicated by:

an assignment recorded on 09/24/2004, from inventor Philip S. Siegel to Ireturnit, Inc., in the Assignment Records of the PTO at Reel 015172, Frame 0526 (3 pages); and

an assignment recorded on 09/24/2004, from Ireturnit, Inc. to Newgistics, Inc., in the Assignment Records of the PTO at Reel 015172, Frame 0543 (2 pages).

Related Appeals and Interferences

Appellant directs the Board's attention to following pending Applications that are under appeal and may be related to or affect the bearing on the Board's decision in this Appeal:

1. United States Patent Application Serial No. 09/817,353, entitled "System And Method For Single-Action Returns of Remotely Purchased Merchandise" filed on March 26, 2001, which claims the benefit of U.S. Provisional Application No. 60/191,811, filed March 24, 2000.

   The Application at issue in this Appeal is a Continuation of United States Patent Application Serial No. 09/817,353.

   A copy of the Appeal Brief filed on April 15, 2009, as relating United States Patent Application Serial No. 09/817,353, is included in Appendix C, attached hereto.

2. United States Patent Application Serial No. 10/750,935, entitled "On-Line Rules-Based Return Processing" filed on January 2, 2004, which is also a Continuation of United States Patent Application Serial No. 09/817,353, entitled "System And Method For Single-Action Returns of Remotely Purchased Merchandise" filed on March 26, 2001, which claims the benefit of U.S. Provisional Application No. 60/191,811, filed March 24, 2000.

   A copy of the Appeal Brief filed on April 15, 2009, as relating United States Patent Application Serial No. 10/750,935, is included in Appendix C, attached hereto.

To the knowledge of Appellant's counsel, there are no other known appeals, interferences, or judicial proceedings that will directly affect or be directly affected by or have a bearing on the Board's decision regarding this Appeal.

Status of Claims

Claims 1-5, 7, 8, and 10-32 are pending with Claims 17-28 being withdrawn. Claims 1-5, 7, 8, 10-16, and 29-32 stand rejected pursuant to the Final Office Action dated November 19, 2008 (*"Final Office Action"*). Specifically, Claims 1-2, 5, 7-8, 13, 15, and 30-32 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,980,962 issued to Arganbright et al. (*"Arganbright"*) in view of U.S. Patent No. 6,246,997 issued to Cybul et al. (*"Cybul"*). Claims 3-4, 10-12, 14, 16, and 29 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Arganbright* in view of *Cybul* and further in view U.S. Patent Application Publication No. 2002/0010634 issued to Roman et al. (*"Roman"*) and Official Notice.

For the reasons discussed below, Appellant respectfully submits that the rejection of Claims 1-5, 7, 8, 10-16, and 29-32 are improper and should be reversed by the Board. Accordingly, Appellant presents Claims 1-5, 7, 8, 10-16, and 29-32 for Appeal. All pending claims are shown in Appendix A, attached hereto.

Status of Amendments

All amendments submitted by Appellant have been entered by the Examiner.

Summary of Claimed Subject Matter

FIGURES 1A-1B illustrate web pages incorporating teachings of the present invention. Specifically, FIGURE 1A illustrates a web access tool displaying a web page containing transaction history 101 which includes individual transactions indicative of merchandise purchased by a user logged on to a client system. This example web page was preferably sent from a server system to the client system when the user logged on to the client system and requested to process a merchandise return. This example web page contains transaction listing 101, returns summary section 102, single-action returns section 103, detailed item description section 104, user identification section 107, and returns information section 108. One skilled in the art can appreciate that these various sections may be omitted, rearranged or adapted in various ways without departing from the spirit and scope of the present invention. In general, the user is preferably made aware of the item or items to be returned by the single action and of the single action needed to begin the returns process. (Page 9, lines 7-26.)

Transaction listing 101 and detailed item description section 104 preferably provide information that identifies and describes the item(s) selected by the user and which may be returned. The server system adds transaction listing 101 and detailed item description 104 to each web page for the item(s) the user has purchased from various retailers. The server system, however, preferably adds single-action returns section 103 when single-action ordering is enabled for the user logged onto the client system. One skilled in the art would appreciate that a single web page on the server system may contain all these sections but single-action returns section 103 may be selectively included or excluded before sending the web page to the client system. (Page 9, line 27 - page 11, line 9.)

Single-action returns section 103 allows the user to specify, with a single action such as a single click of a mouse button, to return items of merchandise selected from individual transactions contained in transactions listing 101. Once the user has performed the preferred single action, the returns process for the selected item(s) is initiated. Single-action returns section 103 preferably contains single-action return button 103a, user identification subsection 103b, and single-action return information subsections 103c and 103d. (Page 10, lines 10-19.)

When the user selects single-action returns button 103a, the client system sends a return request to the server system indicating the user's desire that the merchandise items associated with transactions selected in transaction listing 101 be returned. After the server system

receives the return request, the server system provides the client system with a new web page confirming the receipt of the return request. The processing of the client system and the server system will be discussed in greater detail below. (Page 11, lines 17-26.)

FIGURE 2 is a block diagram illustrating a system incorporating teachings of the present invention. System 200 preferably supports single-action returns over the Internet using the World Wide Web. Server system 210 includes server engine 211, client identifier/customer table 212, various web page templates 213, customer database 214, transaction database 215, and retailer database 216. Server engine 211 preferably receives HTTP (Hypertext Transfer Protocol) requests to access web pages identified by URLs (Universal Resource Locator) and provides the web pages to the various client systems 220. Such an HTTP request may indicate that the user has performed the single action necessary to effect single-action returns. (Page 13, lines 6-19.)

Customer database 214 preferably contains customer information for various users or potential users. Customer information may include user-specific return information such as the name of the customer, credit information, and shipping information in a user preference profile. Transaction database 215 preferably contains entries indicative of transactions associated with registered users, preferably transactions which were performed at single-action returns participating retailers. Retailer database 216 contains a listing of the various retailers that participate in a local returns of remotely purchased merchandise program. Client identifier/customer table 212 contains a mapping from each client identifier, which is a globally unique identifier that uniquely identifies a client system, to the customer last associated with that client system. (Page 13, line 20 - page 14, line 4.)

FIGURE 5 is a flow diagram of a routine capable of processing single-action returns according to one embodiment of the present invention . . . Method 500 of FIGURE 5 begins at step 505. Once initialized, method 500 proceeds to step 510. At step 510, the user of client system 220 is identified. One method of identifying the user of client system 220 is the method of FIGURE 3. An alternative method of identifying the user of client system 220 is to obtain and review client identifier 222, if one is present, on client system 220. If the user of the client system is a new user, i.e., not yet registered or no client identifier 222 is provided, method 500 proceeds to step 515. (Page 17, lines 5-20.)

At step 515, it is determined whether or not the user is to be registered. This determination can be made by prompting the user, or by other means. If the new user does not

wish to be registered for single-action returns services or it is determined that the user is not to be registered, method 500 proceeds to step 520 where method 500 is ended. If the new user wishes to enable single-action returns, method 500 proceeds to step 525. (Page 17, lines 21-28.)

At step 525, a user preference profile for the new user is created and stored preferably on server system 210. Once the new user is registered and the user preference profile stored, a client identifier 222 is deposited on client system 220 and method 500 proceeds to step 535. (Page 17, line 29 - page 18, line 3.)

If at step 510, the user on client system 220 is identified as a registered user, i.e., a client identifier 222 exists on client system 220, method 500 proceeds to step 530. At step 530, the user preference profile of the registered user is retrieved and mapped using customer database 214 and client ID/customer table 212. Once the user preference profile has been retrieved, such as at step 530, or created, such as at step 525, method 500 proceeds to step 535. (Page 18, lines 4-12.)

At step 535, a transaction history for the user is preferably retrieved from transactions database 215. Transactions database 215 is preferably maintained by server system 210. However, transactions database 215 can be maintained at another location as well as created real-time from a collection of databases located at member retail sites, credit card sites or other data bases. Once an appropriate transaction history for the registered user has been retrieved at step 535, method 500 proceeds to step 540. (Page 18, lines 13-22.)

At step 540, the transaction history retrieved at step 535 is preferably displayed to the user for their perusal and subsequent selection of items of merchandise to be returned. The transaction history is preferably displayed in a manner similar to that illustrated in FIGURE 1A. In addition to the transaction history, single-action returns section 103 of the present invention is also preferably included on the displayed web page. Once transaction history 101 and other desired components of a single-action returns web page are displayed, method 500 proceeds to step 545. (Page 18, line 23 - page 20, line 2.)

At step 545, method 500 waits or loops until the user selects a transaction or item to be processed for returns. If a transaction or item is not selected within a predetermined amount of time, method 500 proceeds to step 550 where method 500 ends. Method 500 is designed to end after a predetermined amount of time for security reasons which can arise from client system 220 being left unattended or for other computer security threats. In response to the selection of

an item to be returned and the subsequent selection of single-action returns button 103a at step 545, method 500 proceeds to step 555. At step 555, the processing necessary for the return of the selected item or items of merchandise is initiated. (Page 19, lines 3-15.)

Referring now to FIGURE 6A, one embodiment of a flow diagram capable of completing the processing of a return request incorporating teachings of the present invention is shown. As illustrated in the embodiment of FIGURE 6A, in response to the initiation of returns processing at step 555, method 500a proceeds to step 558. (Page 19, lines 16-21.)

At step 558, the selected item or transaction is evaluated to determine whether or not the return is a valid return. One method of validating a return might involve comparing the item to be returned against a returns rule set for the retailer from which the item was purchased. Alternatively, if the transaction represented the purchase of a perishable item, a return might be determined to not be valid. If it is determined that the selected transaction or item is not a valid return, method 500a proceeds to step 561. (Page 19, lines 22-31.)

At step 561, the user is notified of the invalid return such as by a web page, email, or other capable means. Once the user has been notified that the return is invalid at step 561, method 500a ends at step 564. As an alternative to ending at any end step of methods 500, 500a or 500b, methods 500, 500a or 500b can return to a previous step, such as step 540 where the transaction listing is displayed to the user, or perform other actions within the spirit and scope of the present invention. (Page 20, lines 1-10.)

If at step 558, it is determined that the selected item or transaction for return is valid, method 500a proceeds to step 567. At step 567, the retailer from which the item was purchased is notified of the pending merchandise return. After the appropriate retailer is notified at step 567, the transaction information and the necessary user specific information such as that contained in the user preference profile, is provided to the retailer at step 570. (Page 20, lines 11-19.)

In addition to providing the retailer the necessary transaction information and the necessary user specific information at step 570, a shipping agent is notified of the need for a package pick up such that the item selected by the user may be returned at Step 573. To further simplify processing for both the shipping agent and the user, a return shipping label is preferably produced for the user to place on the package in which the merchandise for return will be shipped back to the retailer at step 576. It is also possible to have shipping paperwork generated and printed out at the facility of the shipping agent. At step 579, the package, once

picked up by the shipping agent, is forwarded to the appropriate destination, such as a retailer depot, auction site, etc. Method 500a completes returns processing at step 582. (Page 20, line 20 - page 21, line 4.)

Referring now to FIGURE 6B, an alternate embodiment of a flow diagram capable of completing the processing of a single-action return request incorporating teachings of the present invention is shown. Similar to FIGURE 6A, in response to the initiation of returns processing at step 555, method 500b proceeds to step 558. (Page 21, lines 5-10.)

At step 558, the selected item or transaction is evaluated to determine whether or not the return is a valid return. One method of validating a return might be to compare the item to be returned against a returns rule set for the retailer from which the item was purchased. Alternatively, if the transaction represented the purchase of a perishable item, a return might be determined to not be valid. If it is determined that the selected transaction or item is not a valid return, method 500b proceeds to step 561. (Page 21, lines 11-20.)

At step 561, the user is notified of the invalid return. Once the user has been notified that the return is invalid at step 561, method 500b ends at step 564. (Page 21, lines 21-23.)

If at step 558, it is determined that the selected item or transaction for return is valid, method 500b proceeds to step 573. At step 573, a shipping agent is notified of a package pick up for the return of the item selected by the user. To further simplify processing for both the shipping agent and the user, a return shipping label is preferably produced for the user to place on the package in which the return will be shipped at step 576. At step 579, the package, once picked up by the shipping agent, is forwarded to its appropriate destination. (Page 21, line 24 - page 23, line 2.)

Once the merchandise to be returned has been received at its destination or while the merchandise is in transit, the merchandise is disposed of at step 585. The present invention envisions a variety of different methods by which the returned merchandise may be disposed of. For example, the merchandise may be auctioned on an auctioning web-site, a live auction may be employed to dispose of the returned merchandise, or as illustrated in FIGURE 6A, the merchandise may be returned to the retailer from which it was purchased. (Page 22, lines 3-12.)

Once the merchandise has been disposed of at step 585, the proceeds of the disposal are credited to the user based upon settings available in the user preference profile at step 588. This method of disposal allows an auctioning agent to obtain the best price for the returned

merchandise and to collect a commission for their role in the disposition of the merchandise should they desire. For products which get returned to the retailer from which they were purchased, the user may be able to obtain a full refund for the unwanted merchandise from the retailer. Other methods of merchandise disposal are considered within the spirit and scope of the present invention. Once the user has been appropriately credited, method 500b completes at step 591. (Page 22, lines 13-26.)

To help minimize shipping costs and user confusion, the server system may combine various single-action returns into a multiple-item return. For example, if a user wishes to return more than one item to any given retailer or central depot, those returns may be cost effectively combined into a single return for shipping. As such, the server system preferably combines the single-action returns when their destination addresses are the same. (Page 22, line 27 - page 24, line 4.)

Although the present invention has been described in detail, it should be understood that various changes, substitutions and alterations can be made thereto without departing from the spirit and scope of the invention. (Page 25, lines 25-28.)

With regard to the independent claims currently under Appeal, Appellant provides the following concise explanation of the subject matter recited in the claim elements. For brevity, Appellant does not necessarily identify every portion of the Specification and drawings relevant to the recited claim elements. Additionally, this explanation should not be used to limit Appellant's claims but is intended to assist the Board in considering the Appeal of this Application.

For example, independent Claim 1 recites the following:

> A method of using the Internet to provide return labels to customers for facilitating returns of merchandise (e.g., Figures 5 and 6A-6B, reference numerals 500-588; Page 17, line 5 through Page 23, line 4), comprising the steps of:
> receiving, from a customer, an electronic request via a web access tool associated with the customer, the electronic request requesting to initiate return processing of merchandise having been purchased by the customer in a prior purchase transaction (e.g., Figure 1, reference numerals 101-110; Page 9, lines 7-16; Figure 5, reference numeral 510; Page 17, lines 10-20);
> in response to receiving the electronic request to initiate return processing from the customer, accessing a database to obtain transaction information associated with the customer, the transaction information identifying at least one item of merchandise having been purchased by

the customer in a prior purchase transaction (e.g., Figure 5, reference numeral 535; Page 18, lines 13-22);

displaying, to the customer via the web access tool, the transaction information comprising a list of the at least one item of merchandise having been purchased by the customer in the prior purchase transaction (e.g., Figure 5, reference numeral 540; Page 18, line 23 through page 19, line 2);

receiving an electronic selection, from the customer, via the web access tool, the electronic selection identifying a particular item of merchandise included in the list of at least one item of merchandise having been purchased by the customer in the prior purchase transaction, the electronic selection comprising a click on the particular item of merchandise in the list displayed to the customer and identifying the particular item of merchandise for returns processing (e.g., Figure 5, reference numeral 545; Page 19, lines 3-15);

in response to receiving the electronic selection comprising the click on the particular item of merchandise in the list of merchandise, initiating a returns process for the particular item of merchandise selected by the consumer from the list of merchandise purchased by the consumer in a prior purchase transaction, the returns process initiated by a returns server (e.g., Figure 2, reference numeral 210; Page 13, lines 6-19; Page 14 lines 5-21; Page 15, line 21 through Page 16, line 14; Figures 6A-6B, reference numerals 558-588; Page 20, line 16 through Page 23, line 26); and

in response to receiving the electronic selection from the customer of the particular item of merchandise having been purchased by the customer in the prior purchase transaction, generating data for printing a return label for the particular item of merchandise selected by the customer (e.g., Figures 6A-6B, reference numeral 576; Page 20, line 20 through Page 21, line 4).

Dependent Claim 16 incorporates the steps of Claim 1 and further recites the following:

delivering data about the return to a customer account record (e.g., Figure 6A, reference numeral 558; Page 21, lines 11-19).

Dependent Claim 29 incorporates the steps of Claim 1 and further recites the following:

the customer information comprises customer-specific credit information or customer-specific shipping information (e.g., Figure 2, reference numeral 214; Page 14 , lines 20-25).

Dependent Claim 30 incorporates the steps of Claim 1 and further recites the following:

in response to receiving the electronic selection from the customer of the particular item of merchandise having been purchased by the customer in the prior purchase transaction, updating a customer profile associated with the customer (e.g., Figures 6A-6B, reference numerals 558-591; Page 20, line 16 through Page 23, line 26).

As another example, independent Claim 32 recites the following:

A method of using the Internet to provide return labels to customers for facilitating returns of merchandise (e.g., Figures 5 and 6A-6B, reference numerals 500-588; Page 17, line 5 through Page 23, line 4), comprising the steps of:

receiving, from a customer, an electronic request via a web access tool associated with the customer, the electronic request requesting to initiate return processing of merchandise having been purchased by the customer in a prior purchase transaction (e.g., Figure 1, reference numerals 101-110; Page 9, lines 7-16; Figure 5, reference numeral 510; Page 17, lines 10-20);

in response to receiving the electronic request from the customer, accessing a customer profile associated with the customer, the customer profile comprising customer-specific credit information or customer-specific shipping information (e.g., Figure 2, reference numeral 214; Page 13, lines 20-25; Figure 4, reference numerals 401-403; Page 16, line 15 through Page 17, line 4; Figure 5, reference numeral 525; Page 17, line 29 through Page 18, line 12; Figures 7A-7C, reference numerals 701-706; Page 23, line 5 through Page 247, line 26);

in response to receiving the electronic request to initiate return processing from the customer, accessing a database to obtain transaction information associated with the customer, the transaction information identifying at least one item of merchandise having been purchased by the customer in a prior purchase transaction (e.g., Figure 5, reference numeral 535; Page 18, lines 13-22);

displaying, to the customer via the web access tool, the transaction information comprising a list of the at least one item of merchandise having been purchased by the customer in the prior purchase transaction (e.g., Figure 5, reference numeral 540; Page 18, line 23 through page 19, line 2);

receiving an electronic selection, from the customer, via the web access tool, the electronic selection identifying a particular item of merchandise included in the list of at least one item of merchandise having been purchased by the customer in the prior purchase transaction, the electronic selection comprising a click on the particular item of merchandise in the list displayed to the customer and identifying the particular item of merchandise for returns processing (e.g., Figure 5, reference numeral 545; Page 19, lines 3-15);

in response to receiving the electronic selection comprising the click on the particular item of merchandise in the list of merchandise, initiating a returns process for the particular item of merchandise selected by the consumer from the list of merchandise purchased by the consumer in a prior purchase transaction, the returns process initiated by a returns server (e.g., Figure 2, reference numeral 210; Page 13, lines 6-19; Page 14 lines 5-21; Page 15, line 21 through Page 16, line 14; Figures 6A-6B, reference numerals 558-588; Page 20, line 16 through Page 23, line 26);

in response to receiving the electronic selection from the customer of the particular item of merchandise having been purchased by the customer in the prior

purchase transaction, generating data for printing a return label for the particular item of merchandise selected by the customer (e.g., Figures 6A-6B, reference numeral 576; Page 20, line 20 through Page 21, line 4);

in response to receiving the electronic selection from the customer of the particular item of merchandise having been purchased by the customer in the prior purchase transaction, updating the customer profile associated with the customer (e.g., Figure 2, reference numeral 214; Page 13, lines 20-25; Figure 4, reference numerals 401-403; Page 16, line 15 through Page 17, line 4; Figure 6B, reference numeral 585; Page 22, lines 13-16); and

sending a notification to a merchant associated with the particular item of merchandise of the pending return, the notification identifying the customer and the particular item of merchandise (e.g., Figure 5, reference numerals 558-570; Page 20, lines 11-19).

Grounds of Rejection to be Reviewed on Appeal

Are Claims 1-2, 5, 7-8, 13, 15, and 30-32 unpatentable under 35 U.S.C. § 103(a) over U.S. Patent No. 6,980,962 issued to Arganbright et al. ("*Arganbright*") in view of U.S. Patent No. 6,246,997 issued to Cybul et al. ("*Cybul*")?

Are Claims 3-4, 10-12, 14, 16, and 29 unpatentable under 35 U.S.C. § 103(a) over *Arganbright* in view of *Cybul* and further in view U.S. Patent Application Publication No. 2002/0010634 issued to Roman et al. ("*Roman*") and Official Notice?

Arguments

The Examiner rejects Claims 1-2, 5, 7-8, 13, 15, and 30-32 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,980,962 issued to Arganbright et al. ("*Arganbright*") in view of U.S. Patent No. 6,246,997 issued to Cybul et al. ("*Cybul*"). The Examiner rejects Claims 3-4, 10-12, 14, 16, and 29 as being unpatentable over *Arganbright* in view of *Cybul* and further in view U.S. Patent Application Publication No. 2002/0010634 issued to Roman et al. ("*Roman*") and Official Notice. For at least the following reasons, Appellant respectfully submits that these rejections are improper and should be reversed by the Board. Appellant addresses independent Claims 1 and 32, and dependent Claims 16, 29, and 30 below.

I.   Legal Standard for Obviousness

The question raised under 35 U.S.C. § 103 is whether the prior art taken as a whole would suggest the claimed invention taken as a whole to one of ordinary skill in the art at the time of the invention. One of the three basic criteria that must be established by an Examiner to establish a *prima facie* case of obviousness is that "the prior art reference (or references when combined) must teach or suggest *all the claim limitations*." *See* M.P.E.P. § 706.02(j) citing *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991) (emphasis added). "*All words* in a claim must be considered in judging the patentability of that claim against the prior art." *See* M.P.E.P. § 2143.03 citing *In re Wilson*, 424 F.2d 1382, 1385 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970) (emphasis added).

In addition, even if all elements of a claim are disclosed in various prior art references, which is certainly not the case here as discussed below, the claimed invention taken as a whole still cannot be said to be obvious without some reason why one of ordinary skill at the time of the invention would have been prompted to modify the teachings of a reference or combine the teachings of multiple references to arrive at the claimed invention.

The controlling case law, rules, and guidelines repeatedly warn against using an Appellant's disclosure as a blueprint to reconstruct the claimed invention. For example, the M.P.E.P. states, "The tendency to resort to 'hindsight' based upon Appellant's disclosure is often difficult to avoid due to the very nature of the examination process. However,

impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art." M.P.E.P. § 2142.

The U.S. Supreme Court's decision in *KSR Int'l Co. v. Teleflex, Inc.* reiterated the requirement that Examiners provide an explanation as to why the claimed invention would have been obvious. *KSR Int'l Co. v. Teleflex, Inc.*, 127 S.Ct. 1727 (2007). The analysis regarding an apparent reason to combine the known elements in the fashion claimed in the patent at issue "should be made explicit." *KSR*, 127 S.Ct. at 1740-41. "Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *Id.* at 1741 (internal quotations omitted).

The new examination guidelines issued by the PTO in response to the *KSR* decision further emphasize the importance of an explicit, articulated reason why the claimed invention is obvious. Those guidelines state, in part, that "[t]he key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR* noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit." *Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in View of the Supreme Court Decision in KSR International Co. v. Teleflex Inc.*, 72 Fed. Reg. 57526, 57528-29 (Oct. 10, 2007) (internal citations omitted). The guidelines further describe a number of rationales that, in the PTO's view, can support a finding of obviousness. *Id.* at 57529-34. The guidelines set forth a number of particular findings of fact that must be made and explained by the Examiner to support a finding of obviousness based on one of those rationales. *See id.*

II. Claims 1-2, 5, 7-8, 13, 15, and 31-32 are Allowable over the Proposed *Arganbright-Cybul* Combination

The *Final Office Action* is deficient at least because the cited references, taken alone or in combination, do not disclose, teach, or suggest all the elements of Appellant's Claims 1-2, 5, 7-8, 13, 15, and 31-32. For example, independent Claim 1 of the present Application, as amended, recites:

A method of using the Internet to provide return labels to customers
for facilitating returns of merchandise, comprising the steps of:

receiving, from a customer, an electronic request via a web access tool associated with the customer, the electronic request requesting to initiate return processing of merchandise having been purchased by the customer in a prior purchase transaction;

in response to receiving the electronic request to initiate return processing from the customer, accessing a database to obtain transaction information associated with the customer, the transaction information identifying at least one item of merchandise having been purchased by the customer in a prior purchase transaction;

displaying, to the customer via the web access tool, the transaction information comprising a list of the at least one item of merchandise having been purchased by the customer in the prior purchase transaction;

receiving an electronic selection, from the customer, via the web access tool, the electronic selection identifying a particular item of merchandise included in the list of at least one item of merchandise having been purchased by the customer in the prior purchase transaction, the electronic selection comprising a click on the particular item of merchandise in the list displayed to the customer and identifying the particular item of merchandise for returns processing;

in response to receiving the electronic selection comprising the click on the particular item of merchandise in the list of merchandise, initiating a returns process for the particular item of merchandise selected by the consumer from the list of merchandise purchased by the consumer in a prior purchase transaction, the returns process initiated by a returns server; and

in response to receiving the electronic selection from the customer of the particular item of merchandise having been purchased by the customer in the prior purchase transaction, generating data for printing a return label for the particular item of merchandise selected by the customer.

Because the proposed *Arganbright-Cybul* combination does not disclose, teach, or suggest at least the claim elements emphasized above, Appellant submits that the rejection of Claim 1 is improper and should be withdrawn. Because independent Claim 32 recites certain similar claim elements, Appellant submits that the rejections of Claim 32 is improper for analogous reasons and should also be withdrawn.

A. **The proposed *Arganbright-Cybul* combination does not disclose, teach, or suggest "*receiving an electronic selection, from the customer, via the web access tool, the electronic selection identifying a particular item of merchandise included in the list of at least one item of merchandise having been purchased by the customer in the prior purchase transaction, the electronic selection comprising a click on the particular item of merchandise in the list displayed to the customer and identifying the particular item of merchandise for returns processing.*"**

As a first example of the deficiencies of the *Arganbright-Cybul* combination, Appellant respectfully submits that the cited references do not disclose, teach, or suggest "receiving an electronic selection, from the customer, via the web access tool, the electronic selection identifying a particular item of merchandise included in the list of at least one item of merchandise having been purchased by the customer in the prior purchase transaction, the electronic selection comprising a click on the particular item of merchandise in the list displayed to the customer and identifying the particular item of merchandise for returns processing," as recited in Claim 1. In the *Final Office Action*, the Examiner acknowledges that *Arganbright* does not disclose the recited claim elements and relies, specifically, upon *Cybul*. (*Final Office Action*, page 5). Appellant respectfully disagrees.

The cited portion of *Cybul* merely discloses "a list builder tool" that "efficiently find[s] and select[s] the past shopping history of respective shoppers and import[s] that data to the list builder's on-line historical purchase list database, thereby making it available for the shoppers' first and subsequent on-line shopping experiences." (*Cybul*, Column 4, lines 25-35). Thus, the selection referred to by *Cybul* is performed by a server-based "list builder tool." The application finds and selects items previously purchased by the customer. The selection, however, is not by a customer, via a web access tool. The selection is not a click on the particular item of merchandise, and the selection does not identify a particular item of merchandise for returns processing. Accordingly, it continues to be Appellant's position that neither *Arganbright* nor *Cybul* (or their proposed combination) disclose, teach, or suggest "receiving an **electronic selection, from the customer, via the web access tool**, the electronic selection identifying a particular item of merchandise included in the list of at least one item of merchandise having been purchased by the customer in the prior purchase transaction, **the electronic selection comprising a click on the particular item of merchandise in the list displayed to the customer and identifying the particular item of merchandise for returns processing**," as recited in Claim 1. The recited claim elements are absent from the disclosures of *Arganbright* and *Cybul*.

Additionally, Appellant submits that it would not have been obvious to one of ordinary skill in the art at the time the invention was made to modify *Arganbright* in view of *Cybul* to include an electronic selection from a displayed list of items to the consumer to identify an item for returns processing. *Arganbright* discloses that the process for handling returns begins when "the system presents the user with a copy of the satisfaction guarantee 2702." (Column 63,

lines 3-5). Thus, the process initiates with the presentation of the return policy to the user. "After the user has a chance to review satisfaction guarantee 2702, the user selects whether the user wishes to "return" or "exchange" (box 2704) an item or plurality of items." (Column 63, lines 8-11). Thus, the first electronic request received from the user relating to the return of a product is the selection of either a "return" button or an "exchange" button. "If the user selects "return," an online return form 2706 is presented to the user." (Column 63, lines 12-13). "The user is then requested <u>to enter a plurality of information</u> (box 2708) on return form 2706, including but not limited to, quantity, stock number or SKU, the reason for the return, product description, and an invoice number." (Column 63, lines 13-17, emphasis added). Once the return form is populated by the customer's input, the return form is "presented to the user in a format (box 2710) that can be printed on a conventional printer connected to the user's computer" and that the user "is requested to print the form and include the form in the box containing the product or products to be returned." (Column 63, lines 23-29). Thus, the form must be filled out by the customer and the transaction information is provided in the box of merchandise returned by the customer. Nothing is presented to the user that would be appropriate for selection by a click on a particular item of merchandise to identify that item for returns processing.

Even when considered in conjunction with the disclosure of *Cybul*, Appellant's claim language would not have been obvious to one of ordinary skill in the art. As discussed above, *Cybul* relates to a system for online shopping that "takes advantage of the data already being gathered by POS systems on consumer shopping habits and preferences." (*Cybul*, Column 1, lines 36-38). Specifically, *Cybul* discloses that where a vendor's POS system "supports a frequent shopper or loyalty program . . . [or]a database of historical purchase data indexed by loyalty customer," the information may be extracted from the vendor's POS system. (*Cybul*, Column 4, lines 25-34; Column 1, lines 63-65). As a result, a list builder tool can "efficiently find and select the past shopping history of respective shoppers and import that data to the list builder's on-line historical purchase list database, thereby making it available for the shoppers' first and subsequent on-line shopping experiences." (*Cybul*, Column 4, lines 29-34). As such, *Cybul* merely discloses that a shopper's purchases in a brick-and-mortar store are used to develop an online shopping list for that shopper's subsequent purchases on-line.

Accordingly, at most the *Arganbright-Cybul* combination discloses that during an online purchase, a customer's in store purchases may be used to efficiently develop an on-line

shopping list. If an item were needed to be returned after the purchase is complete, the proposed combination merely discloses that a return form could be obtained on-line and filled out by the customer on the customer's computer, as disclosed in *Arganbright*. The form would then be printed and placed in the box for shipping. It would not have been obvious to one of ordinary skill in the art to modify the return process of *Arganbright* and the purchase process of *Cybul* to result in Appellant's recited step of "receiving an **electronic selection, from the customer, via the web access tool**, the electronic selection identifying a particular item of merchandise included in the list of at least one item of merchandise having been purchased by the customer in the prior purchase transaction, **the electronic selection comprising a click on the particular item of merchandise in the list displayed to the customer and identifying the particular item of merchandise for returns processing**," as recited in Claim 1.

For at least these reasons, Appellant respectfully requests reconsideration and allowance Claims 1, together with Claims 2, 5, 7-8, 13, 15, and 31 that depend on Claim 1. For analogous reasons, Appellant also requests reconsideration and allowance of independent Claim 32.

> **B.**   **The proposed *Arganbright-Cybul* combination does not disclose, teach, or suggest "*in response to receiving the electronic selection comprising the click on the particular item of merchandise in the list of merchandise, initiating a returns process for the particular item of merchandise selected by the consumer from the list of merchandise purchased by the consumer in a prior purchase transaction, the returns process initiated by a returns server.*"**

As a second example of the deficiencies of the *Arganbright-Cybul* combination, Appellant respectfully submits that the cited references do not disclose, teach, or suggest "in response to receiving the electronic selection comprising the click on the particular item of merchandise within the list of merchandise, initiating a returns process for the particular item of merchandise selected by the consumer from the list of merchandise purchased by the consumer in the prior purchase transaction, the returns process initiated by a returns server," as recited in Claim 1.

In the *Final Office Action*, the Examiner relies upon *Arganbright* for the operation of initiating a returns process by a returns server in response to a selection of an item. (*Final Office Action*, pages 4-5). Specifically, the Examiner states "*Arganbright* teaches receiving from the consumer an electronic request to initiate return processing (see at least col. 63 lines 1-35)." (*Final Office Action*, page 10). Initially, Appellant respectfully notes that Appellant's

claim does not merely recite receiving from the consumer an electronic request to initiate return processing. Appellant's claim recites "initiating a returns process for the particular item of merchandise . . . by a returns server," and this operation is not disclosed in *Arganbright*.

Arganbright merely discloses that "[a]fter the user has a chance to review satisfaction guarantee 2702, the user selects whether the user wishes to "return" or "exchange" (box 2704) an item or plurality of items." (Column 63, lines 8-11). Thus, this portion refers to the selection of either a "return" button or an "exchange" button by a user. Appellant points out that the selection of the "return" button occurs before the user populates the form and before the user identifies a product by sku # for return. (Column 63, lines 12-22). As a result, the selection of the "return" button occurs before an item of merchandise is identified for return. The mere presentation of form before the identification of the product to be returned is not analogous to "initiating a returns process for the particular item of merchandise selected by the consumer from the list of merchandise purchased by the consumer in the prior purchase transaction," as recited by Appellant's amended Claim 1. Further, because there is no disclosure in *Arganbright* of any returns processing being initiated after the form is populated, the system of *Arganbright* cannot be said to perform any returns processing.

Appellant additionally notes that in the *Final Office Action* the Examiner relies upon *Cybul* for disclosure of the electronic selection of the particular item of merchandise and upon *Arganbright* for the operation of initiating a returns process by a returns server. (*Final Office Action*, pages 4-5). However, Appellant's claim recites a specific order to and interrelation between the steps of the claimed method. Specifically, Claim 1 recites "in response to receiving the electronic selection comprising the click on the particular item of merchandise within the list of merchandise, initiating a returns process for the particular item of merchandise selected by the consumer from the list of merchandise purchased by the consumer in the prior purchase transaction, the returns process initiated by a returns server." Thus, a click on a particular item of merchandise previously purchased by a customer is first received from a customer. Then, in response to that click, a returns process for the selected item of merchandise is initiated by a returns server.

To the extent that *Arganbright* discloses initiating a returns process by a returns server (which Appellant expressly disputes above), such returns process is not "in response receiving the electronic selection comprising the click on the particular item of merchandise within the list of merchandise" from the customer. Appellant also notes that *Cybul* does not at all relate to

a returns process or to the processing of returns of merchandise. Even more troubling, as shown above in Section II(A) of this Appeal, *Cybul* does not even disclose the recited "electronic selection comprising the click on the particular item of merchandise" from the customer. The M.P.E.P. provides that "[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art." M.P.E.P. § 2143.03 (citing *In re Wilson*, 424 F.2d 1382, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970)). Because of the deficiencies of these references and the deficiencies of their proposed combination, Appellant respectfully submits that the piecemeal rejection of Appellant's claim over the proposed *Arganbright-Cybul* combination fails to give credence to the particular combination of claim elements and the sequence of claim steps specifically recited in Appellant's claim.

For at least these additional reasons, Appellant respectfully requests reconsideration and allowance Claims 1, together with Claims 2, 5, 7-8, 13, 15, and 31 that depend on Claim 1. For analogous reasons, Appellant also requests reconsideration and allowance of independent Claim 32.

> **C.** **The proposed *Arganbright-Cybul* combination does not disclose, teach, or suggest "*in response to receiving the electronic request to initiate return processing from the customer, accessing a database to obtain transaction information associated with the customer, the transaction information identifying at least one item of merchandise having been purchased by the customer in a prior purchase transaction.*"**

As a third example of the deficiencies of the *Arganbright-Cybul* combination, Appellant respectfully submits that the cited references do not disclose, teach, or suggest "in response to receiving the electronic request to initiate return processing from the customer, accessing a database to obtain transaction information associated with the customer, the transaction information identifying at least one item of merchandise having been purchased by the customer in a prior purchase transaction," as recited in Claim 1.

In the *Final Office Action*, the Examiner relies upon *Arganbright* for disclosure of receiving the electronic request to initiate return processing and upon *Cybul* for disclosure of accessing a database to obtain transaction information identifying at least one item of merchandise having been purchased by the customer. (*Final Office Action*, pages 4-5). Appellant notes, however, that Appellant's claim recites a specific order to and interrelation between the steps of the claimed method. Specifically, an electronic request to initiate return processing is first received from a customer. Then, in response to that electronic request, a

database is accessed to obtain transaction information identifying at least one item of merchandise having been purchased by the customer. To the extent that *Cybul* discloses accessing a database to obtain transaction information associated with the customer, the operation is not "in response to receiving the electronic request to initiate return processing from the customer." The M.P.E.P. provides that "[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art." M.P.E.P. § 2143.03 (citing *In re Wilson*, 424 F.2d 1382, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970)). Because of the deficiencies of these references and the deficiencies of their proposed combination, Appellant respectfully submits that the piecemeal rejection of Appellant's claim over the proposed *Arganbright-Cybul* combination fails to give credence to the particular combination of claim elements and the sequence of claim steps specifically recited in Appellant's claim.

For at least these additional reasons, Appellant respectfully requests reconsideration and allowance Claims 1, together with Claims 2, 5, 7-8, 13, 15, and 31 that depend on Claim 1. For analogous reasons, Appellant also requests reconsideration and allowance of independent Claim 32.

III. Claim 16 is Allowable over the *Arganbright-Cybul-Roman-Official Notice* Combination

Dependent Claim 16 depends upon independent Claim 1, which Appellant has shown above to be allowable. Accordingly, dependent Claim 16 is not obvious over the proposed combination of references at least because Claim 16 includes the limitations of independent Claim 1. Additionally, the *Final Office Action* is further deficient because the cited references, taken alone or in combination, do not disclose, teach, or suggest all the elements of Appellant's dependent Claim 16.

For example, the proposed *Arganbright-Cybul-Roman-Official Notice* combination does not disclose, teach, or suggest "delivering data about the return to a customer account record," as recited in Claim 16. In the *Final Office Action*, the Examiner acknowledges that neither *Arganbright* nor *Cybul* disclose the recited claim elements and instead relies upon *Roman. (Final Office Action*, page 8). However, *Roman* merely discloses that the return product is "verified against the pre-authorized acceptance policy and the e-tailer is notified via the internet or direct connection between the e-tailer and ClickReturns.com." (*Roman*,

Paragraph 22, lines 6-10). Thus, the cited portion of *Roman* only discloses that the merchant is notified of the return. There is no disclosure in *Roman* of "delivering data about the return to a customer account record," as recited in Claim 16.

For at least these reasons, Appellant respectfully requests reconsideration and allowance Claim 16.

IV.   Claim 29 is Allowable over the Proposed *Arganbright-Cybul-Roman-Official Notice* Combination

Claim 29 depends upon independent Claim 1, which Appellant has shown above to be allowable. Accordingly, dependent Claim 29 is not obvious over the various combinations of references relied upon by the Examiner at least because Claim 29 includes the limitations of Claim 1. Additionally, dependent Claim 29 recites further elements that distinguish Appellant's claims over the prior art of record. For example, Claim 29 recites accessing a database to obtain customer information about the customer "wherein the customer information comprises customer-specific credit information or customer-specific shipping information." In the *Final Office Action*, the Examiner acknowledges that "[n]either Arganbright/Roman expressly teach customer information comprising customer-specific credit information or customer-specific shipping information." (*Final Office Action*, page 8). However, the Examiner takes Official Notice that the claim elements are well known and old in the art. (*Final Office Action*, pages 8-9).

Appellant traverses the Examiner's taking of Official Notice. Although the M.P.E.P. suggests that it might not be unreasonable for the examiner to take official notice of facts by asserting that certain limitations in a dependent claim are old and well known expedients in the art without the support of documentary evidence, the M.P.E.P. specifically states that Official Notice is only appropriate "provided the facts so noticed are of notorious character and serve only to "fill in the gaps" which might exist in the evidentiary showing made by the examiner to support a particular ground of rejection." (M.P.E.P., §2144.03, citing *In re Zurko*, 258 F.3d 1379, 1385, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001); *Ahlert*, 424 F.2d at 1092, 165 USPQ at 421.). Such is not the case here. For example, Claim 29 recites "the customer information comprises customer-specific credit information or customer-specific shipping information." There is no disclosure in *Arganbright*, *Cybul*, or *Roman* of these claim elements. Additionally, the recited claim elements do not "fill in the gaps" of *Arganbright*, *Cybul*, or *Roman*.

Additionally, the Examiner has provided no evidence to support the Examiner's contention that Appellant's customer information comprising "customer-specific credit information or customer-specific shipping information," as recited in Appellant's dependent Claim 29, is indeed "old and well known" in the art.

In this case, it would <u>not</u> be appropriate for the examiner to take official notice of the claim elements of Claim 29 without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known. (M.P.E.P., §2144.03). Accordingly, to the extent that the Examiner maintains this rejection based on "Official Notice," "well-known art," common knowledge, or other information within the Examiner's personal knowledge, Appellant respectfully requests that the Examiner cite a reference in support of this position or provide an affidavit in accordance with M.P.E.P. § 2144.03 and 37 C.F.R. § 1.107.

For at least these reasons, Appellant respectfully requests reconsideration and allowance Claims 29.

V.   Claim 30 is Allowable over the *Arganbright-Cybul* Combination

Dependent Claim 30 depends indirectly upon independent Claim 1, which Appellant has shown above to be allowable. Accordingly, dependent Claim 30 is not obvious over the proposed combination of references at least because Claim 30 includes the limitations of independent Claim 1. Additionally, the *Final Office Action* is further deficient because the cited references, taken alone or in combination, do not disclose, teach, or suggest all the elements of Appellant's dependent Claim 30.

For example, the proposed *Arganbright-Cybul* combination does not disclose, teach, or suggest "in response to receiving the electronic selection from the customer of the particular item of merchandise having been purchased by the customer in the prior purchase transaction, updating a customer profile associated with the customer," as recited in Claim 30. In the *Final Office Action*, the Examiner relies specifically upon *Arganbright* for disclosure of the recited claim elements. (*Final Office Action*, page 6). However, *Arganbright* merely discloses a program that "tracks a Member's shopping history." (*Arganbright*, Column 65, lines 7-10). Thus, the system of *Arganbright* stores a listing of the items that a customer purchases. There is no disclosure in *Arganbright* or the *Arganbright-Cybul-*

Roman-Official Notice combination of "in response to receiving the electronic selection from the customer of the particular item of merchandise having been purchased by the customer in the prior purchase transaction, updating a customer profile associated with the customer," as recited in Claim 30.

For at least these reasons, Appellant respectfully requests reconsideration and allowance Claim 30.

VI. The *Arganbright-Cybul* and *Arganbright-Roman-Cybul* Combinations are Improper as Applied to Appellant's Claims

Furthermore, Appellant submits that the Examiner has not presented a legally sufficient argument demonstrating a motivation to combine *Arganbright* with *Cybul* and/or *Roman.*

According to the M.P.E.P., in order "[t]o establish a prima facie case of obviousness . . . there must be some suggestion or motivation either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings." See §2143. Notably absent from this list is an allowance for an Examiner's conjectured assertion as to the motivation to combine reference teachings. A quote from the M.P.E.P. is directed specifically to this point: "[t]he examiner and the board asserted that it would have been within the skill of the art to substitute one type of detector for another in the system of the primary reference, however the court found there was **no support or explanation** of this conclusion and reversed." See §2143.01 (I) (emphasis added). Thus, "the proper inquiry is whether there is something in the prior art as a whole to suggest the *desirability* . . . of making the combination." *Id.* (internal quotations omitted) (emphasis original). "The mere fact that the references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the **desirability** of the combination." See §2143.01 (III) (emphasis original and added). Most recently, this requirement has been reaffirmed in an official USPTO memorandum dated May 3, 2007 wherein the Deputy Commissioner for Patent Operations pointed to sections of *KSR v. Teleflex*, which recite, "it will be necessary . . . to determine whether there was an **apparent reason** to combine the known elements in the fashion claimed by the patent at issue." *KSR Int'l. Co v. Teleflex Inc.,* No. 04-1350 (April 30, 2007) (emphasis added).

As applied to the present application, the *Final Office Action* has failed to meet this burden because the Examiner has not shown "something in the prior art as a whole to suggest the *desirability*" of combining *Arganbright* with *Cybul* and/or *Roman*, but rather seems to rely on a conjectured assertion that "the references can be combined" without regard to the "desirability of the combination." This directly conflicts with the M.P.E.P. requirements for supporting a motivation to combine references. Specifically, the Examiner only states "it would have been obvious . . . to incorporate the teachings of *Cybul* into the disclosure of *Arganbright* in order to provide the consumer with the option to return items via internet or online." (*Final Office Action*, page 3). Additionally, the Examiner states that "it would have been obvious . . . to incorporate the teachings of *Roman* into the disclosure of *Arganbright* in order to prevent the invalid return of merchandise." (*Final Office Action*, page 7). These bald assertions do not meet the requirements of the M.P.E.P. The Examiner did not provide "support or explanation" for the motivation to make the proposed combinations nor did the Examiner show any "desirability" of doing so. Instead, the Examiner seems to base this assertion on pure conjecture. The alleged advantages provided by the Examiner do not provide an explanation as to: (1) why it would have been obvious to one of ordinary skill in the art at the time of Appellant's invention *without using Appellants' claims as a guide* to modify the particular techniques disclosed in *Arganbright* with the cited disclosure in *Roman*; (2) how one of ordinary skill in the art at the time of Applicants' invention would have actually done so; and (3) how doing so would purportedly meet the limitations of Claim 1. Indeed, if it were sufficient for Examiners to merely point to a purported advantage of one reference and conclude that it would have been obvious to combine of modify that reference with other references simply based on that advantage (which, as should be evident from the case law discussed above, it certainly is not), then virtually any two or more references would be combinable just based on the fact the one reference states an advantage of its system. Of course, as the Federal Circuit has made clear and as discussed above, that is not the law.

For at least these reasons, Appellant requests that the rejections of the present claims be withdrawn for want of a *prima facie* showing of obviousness as defined by the M.P.E.P. and for the various other reasons described above.
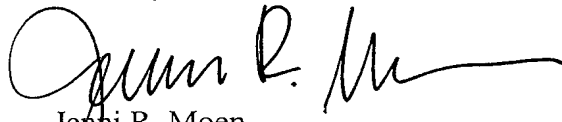
CONCLUSION

Appellant has demonstrated that the present invention, as claimed, is clearly distinguishable over the prior art cited by the Examiner. Therefore, Appellant respectfully requests the Board to reverse the final rejections and instruct the Examiner to issue a Notice of Allowance with respect to all pending claims.

The Commissioner is hereby authorized to charge $270.00 for filing this Brief in support of an Appeal to Deposit Account No. 02-0384 of Baker Botts, L.L.P. No other fees are believed due; however, the Commissioner is authorized to charge any additional fees or credits to Deposit Account No. 02-0384 of Baker Botts, L.L.P.

Respectfully submitted,

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APPENDIX A

Pending Claims

1.   **(Previously Presented)** A method of using the Internet to provide return labels to customers for facilitating returns of merchandise, comprising the steps of:

receiving, from a customer, an electronic request via a web access tool associated with the customer, the electronic request requesting to initiate return processing of merchandise having been purchased by the customer in a prior purchase transaction;

in response to receiving the electronic request to initiate return processing from the customer, accessing a database to obtain transaction information associated with the customer, the transaction information identifying at least one item of merchandise having been purchased by the customer in a prior purchase transaction;

displaying, to the customer via the web access tool, the transaction information comprising a list of the at least one item of merchandise having been purchased by the customer in the prior purchase transaction;

receiving an electronic selection, from the customer, via the web access tool, the electronic selection identifying a particular item of merchandise included in the list of at least one item of merchandise having been purchased by the customer in the prior purchase transaction, the electronic selection comprising a click on the particular item of merchandise in the list displayed to the customer and identifying the particular item of merchandise for returns processing;

in response to receiving the electronic selection comprising the click on the particular item of merchandise in the list of merchandise, initiating a returns process for the particular item of merchandise selected by the consumer from the list of merchandise purchased by the consumer in a prior purchase transaction, the returns process initiated by a returns server; and

in response to receiving the electronic selection from the customer of the particular item of merchandise having been purchased by the customer in the prior purchase transaction, generating data for printing a return label for the particular item of merchandise selected by the customer.

2.   **(Original)** The method of Claim 1, wherein the displaying step is performed by displaying a return information web page.

3. **(Original)** The method of Claim 2, further comprising the step, performed after the receiving step, of displaying a return confirmation message on a new web page.

4. **(Original)** The method of Claim 1, further comprising the step, performed after the receiving step, of displaying a return confirmation message on the return information web page.

5. **(Previously Presented)** The method of Clam 1, further comprising the step of accessing a database to obtain customer information about the customer, and wherein the displaying step includes displaying at least part of the customer information.

7. **(Original)** The method of Claim 1, further comprising the step of accessing a database to obtain merchant return rules.

8. **(Original)** The method of Claim 7, wherein the displaying step includes displaying at least one of the merchant return rules.

10. **(Previously Presented)** The method of Claim 1, further comprising the step, performed prior to the generating step, of determining whether the return is valid.

11. **(Original)** The method of Claim 10, further comprising the step of notifying the customer of an invalid return.

12. **(Previously Presented)** The method of Claim 10, wherein the step of determining whether the return is valid is performed by accessing one or more returns rules associated with the merchant.

13. **(Original)** The method of Claim 1, further comprising the step of notifying a merchant of the return item.

14. **(Original)** The method of Claim 1, further comprising the step of notifying a merchant of information about the customer.

15.   **(Original)**   The method of Claim 1, further comprising the step of downloading the data for printing a return label to the web access tool.

16.   **(Original)** The method of Claim 1, further comprising the step of delivering data about the return to a customer account record.

29.   **(Previously Presented)**   The method of Claim 5, wherein the customer information comprises customer-specific credit information or customer-specific shipping information.

30.   **(Previously Presented)** The method of Claim 1, further comprising:

in response to receiving the electronic selection from the customer of the particular item of merchandise having been purchased by the customer in the prior purchase transaction, updating a customer profile associated with the customer.

31.   **(Previously Presented)**   The method of Claim 1, further comprising electronically sending a notification to a merchant associated with the particular item of merchandise of the pending return, the notification identifying the customer and the particular item of merchandise.

32.   **(Previously Presented)**   A method of using the Internet to provide return labels to customers for facilitating returns of merchandise, comprising the steps of:

receiving, from a customer, an electronic request via a web access tool associated with the customer, the electronic request requesting to initiate return processing of merchandise having been purchased by the customer in a prior purchase transaction;

in response to receiving the electronic request from the customer, accessing a customer profile associated with the customer, the customer profile comprising customer-specific credit information or customer-specific shipping information;

in response to receiving the electronic request to initiate return processing from the customer, accessing a database to obtain transaction information associated with the customer, the transaction information identifying at least one item of merchandise having been purchased by the customer in a prior purchase transaction;

displaying, to the customer via the web access tool, the transaction information comprising a list of the at least one item of merchandise having been purchased by the customer in the prior purchase transaction;

receiving an electronic selection, from the customer, via the web access tool, the electronic selection identifying a particular item of merchandise included in the list of at least one item of merchandise having been purchased by the customer in the prior purchase transaction, the electronic selection comprising a click on the particular item of merchandise in the list displayed to the customer and identifying the particular item of merchandise for returns processing;

in response to receiving the electronic selection comprising the click on the particular item of merchandise in the list of merchandise, initiating a returns process for the particular item of merchandise selected by the consumer from the list of merchandise purchased by the consumer in a prior purchase transaction, the returns process initiated by a returns server;

in response to receiving the electronic selection from the customer of the particular item of merchandise having been purchased by the customer in the prior purchase transaction, generating data for printing a return label for the particular item of merchandise selected by the customer;

in response to receiving the electronic selection from the customer of the particular item of merchandise having been purchased by the customer in the prior purchase transaction, updating the customer profile associated with the customer; and

sending a notification to a merchant associated with the particular item of merchandise of the pending return, the notification identifying the customer and the particular item of merchandise.

APPENDIX B

Evidence Appendix

Other than the references attached to this Appeal Brief as Appendices A and B, no evidence was submitted pursuant to 37 C.F.R. §§ 1.130, 1.131, or 1.132, and no other evidence was entered by the Examiner and relied upon by Appellant in the Appeal.

APPENDIX C

Related Proceedings Appendix

As stated on Page 3 of this Appeal Brief, United States Patent Application Serial No. 09/817,353 and United States Patent Application Serial No. 10/750,935 are under appeal and may be related to or affect the bearing on the Board's decision in this Appeal. Accordingly, copies of the Appeal Briefs for these pending Applications are attached.